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Supreme Court of the United States.

OCTOBER TERM, 1886. No. 1092.

The Clay Commercial Telephone Co. et al.,

APPELLANTS,

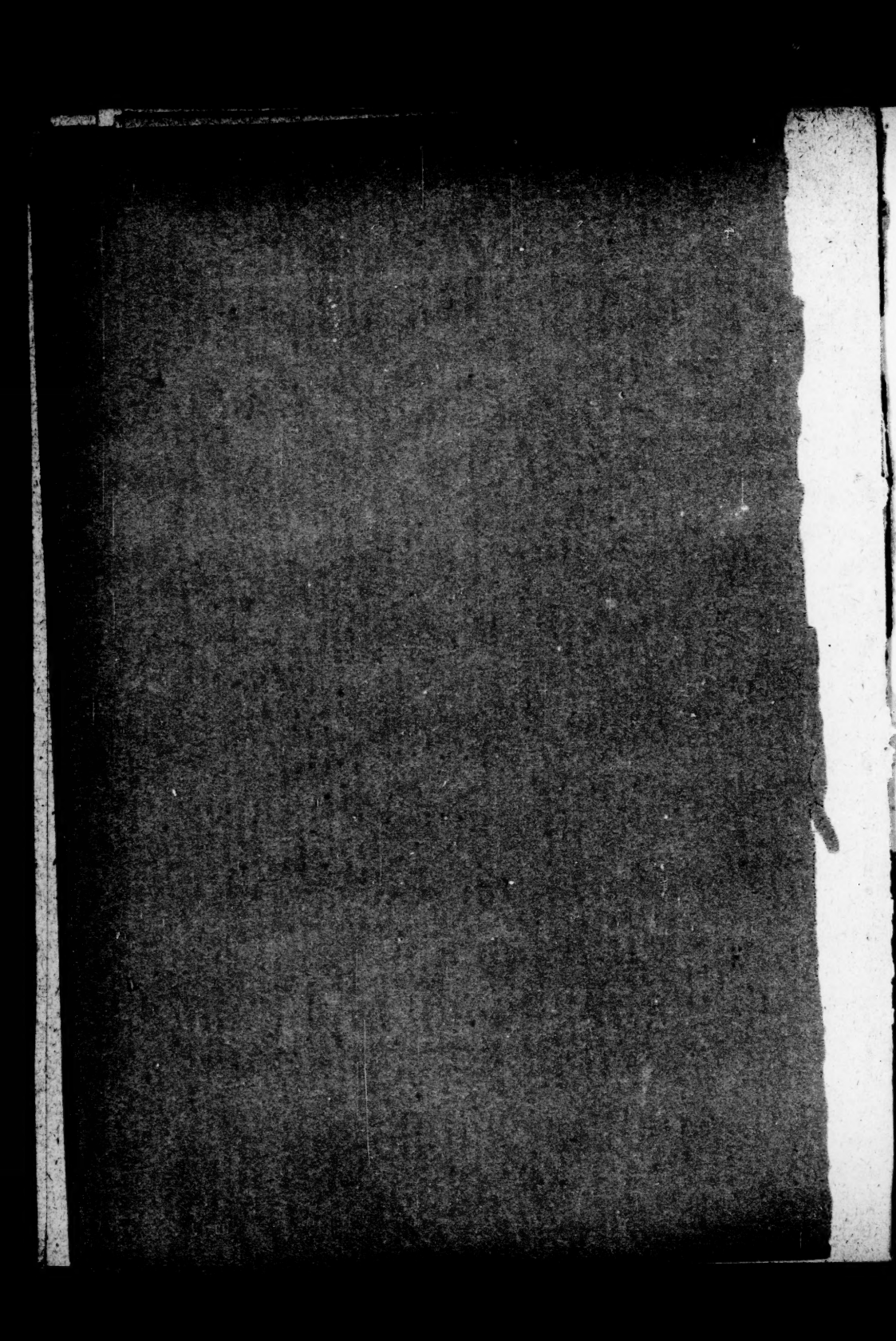
vs.

American Bell Telephone Co. et al.

Appeal from the Circuit Court of the United States for the Eastern District of Pennsylvania.

BRIEF FOR APPELLANTS.

WILLIAM W. KER,
Of Counsel for Appellants.



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THE CLAY COMMERCIAL TELEPHONE COMPANY ET AL., APPELLANTS,

vs.

AMERICAN BELL TELEPHONE COMPANY ET AL.

APPEAL FROM THE CIRCUIT COURT OF THE UNITED STATES FOR THE EASTERN DISTRICT OF PENNSYLVANIA.

BRIEF FOR APPELLANTS.

I.

STATEMENT OF THE CASE.

This is a suit in equity brought in the Circuit Court of the United States for the Eastern District of Pennsylvania. On April 24th, 1884, the American Bell Telephone Company and the Bell Telephone Company of Philadelphia, filed their bill of complaint against the Clay Commercial Telephone Company, John C. Scott, James McMillan, George W. Bratton, Samuel P. Godwin, Alonzo P. Douglass, W. Harrison Godwin, Henry Clay, John J. Bailey, John Marston, Jr., Thomas C. Else, James McC. Creighton, and Joseph Wright.

ANALYSIS OF THE BILL OF COMPLAINT.

The material allegations set forth in the bill of complaint are:

That the American Bell Telephone Company is a corporation duly established under the laws of the Commonwealth of Massachusetts.

That the Bell Telephone Company of Philadelphia is a corporation duly established under the laws of Pennsylvania.

That on February 14th, 1876, Alexander Graham Bell, being the original and first inventor, made application to the Commissioner of Patents of the United States, and on March 7th, 1876, letters patent, No. 174,465, for certain new and useful improvements in telegraphy, were issued and delivered to him.

That on January 15th, 1877, Bell, being the original and first inventor, made application to the Commissioner of Patents of the United States, and on January 30th, 1877, letters patent, No. 186,787, for certain new and useful improvements in electric telegraphy, were issued and delivered to him.

That afterward, in July, 1877, Bell assigned unto Gardiner G. Hubbard, trustee, each of the letters patent aforesaid.

That on July 20th, 1878, the said Gardiner G. Hubbard, trustee, assigned the said letters patent, and each of them, unto the Bell Telephone Company, a corporation established under the laws of the Commonwealth of Massachusetts.

That on June 22d, 1880, the said Bell Telephone Company granted and conveyed unto the American Bell Telephone Company the exclusive right under the said letters patent, and each of them, to the whole of the United States except the State of Massachusetts.

That on April 23d, 1881, the said Bell Telephone Company granted and conveyed unto the American Bell Telephone Company the exclusive right under the said letters patent, and each of them, to the State of Massachusetts.

That the sole right to manufacture electric speaking tele-

phones under said patents thereby became, and still is, vested in the said American Bell Telephone Company.

That by license under the said American Bell Telephone Company the Bell Telephone Company of Philadelphia has acquired the sole and exclusive right to use telephones within a certain territory, which includes the city and county of Philadelphia.

That electric speaking telephones had never been publicly known or used before the grant of said patent No. 174,465, and were first publicly made known and introduced into public use by Bell, under the said patents No. 174,465 and No. 186,787.

That the transmission of articulate speech, telegraphically, according to the method invented by Bell, and patented to him as aforesaid, constituted an entirely new industrial art.

That since the 1st day of February, in the year 1884, the defendants JOINTLY made, used, and furnished to others for use, in the city of Philadelphia and elsewhere in the Eastern District of Pennsylvania, electric speaking telephones, each of which is constructed and adapted for the transmission of articulate speech by and according to the method described and claimed in said patent to Bell, No. 174,465, and each of which embraces and embodies in one integral organization the inventions and improvements, or material and substantial parts thereof, described and claimed in said patents to Bell, No. 174,-465 and No. 186,787, respectively, in violation and infringement of the exclusive rights of complainants.

The bill prays for a perpetual injunction against all the defendants.

ANALYSIS OF THE ANSWERS FILED BY THE DEFENDANTS.

The Clay Commercial Telephone Company, one of the defendants below, on August 3d, 1884, filed a separate answer, admitting it to be true that the said letters patent, No. 174,-465 and No. 186,787, were issued to the said Alexander Graham Bell, but denying all and singular the allegations in the said bill, "that the said Bell was the original and first inventor of

the alleged improvements described and claimed in the said letters patent, and that the same had not been known or used by others in this country, nor patented or described in any printed publication in this or any foreign country before his alleged invention or discovery, and that the same had not been in public use or on sale for more than two years prior to his said application for the said respective letters patent, but alleged the contrary thereof." The material allegations and averments in the answer of this defendant being:

That on December 9th, 1876, Bell caused letters patent to be taken out on his behalf in London, in the Kingdom of Great Britain; that afterward, in consequence of some judicial or other public proceeding, Bell or his representatives made and filed certain alterations and disclaimers in the specification or description forming a part of the said English letters patent, thereby disclaiming many material matters which in this country are claimed by and in behalf of Bell, whereby the patented claims made by or on behalf of Bell in Great Britain, and those made by him or in his behalf in this country, have become repugnant to and inconsistent with each other;

That the substantial and material parts of the things described and claimed in the letters patent dated January 30th, 1877, No. 186,787, are described and claimed by Bell in the prior letters patent of March 7th, 1876, No. 174,465; that the substantial and material parts of the things described and claimed in the letters patent of January 30th, 1877, No. 186,-787, were described and claimed in the prior foreign letters patent taken out for Bell in England; that the English letters patent bear date December 9th, 1876, and inasmuch as the subsequent letters patent of the United States, No. 186,787, do not bear even date with the foreign letters patent, and are not limited to expire therewith, the letters patent of January 30th, 1877, No. 186,787, are null and void;

That it has no knowledge that the complainants are corporations duly established under the laws of the State of Massachusetts and of the State of Pennsylvania respectively; that the

alleged title as set forth in the bill does not authorize the complainants to bring or maintain the bill, or to assert the rights and claim the relief in manner and form therein and thereby asserted and claimed; that the bill is defective for want of proper and sufficient parties thereto; and that it prays that the complainants may be required to make due proof of all and singular the grants, assignments, and licenses in said bill mentioned, and of their allegations in this behalf;

That it denies that electric speaking telephones had never been publicly known or used before the grant to Bell of said patent, No. 174,465; or that they were first publicly made known and introduced into public use by Bell, under the said patents No. 174,465 and No. 186,787; or that Bell was the original and first inventor of said alleged inventions;

That it denies that the transmission of articulate speech, telegraphically, according to the method alleged to have been invented by Bell, and patented to him by the two several patents aforesaid, constituted an entirely new industrial art; that, on the contrary, these allegations and claims are in direct conflict with the publicly well known and the printed and published history of telephony; that his alleged discoveries or inventions, without the aid and employment of the inventions and discoveries of others, were incapable of accomplishing such results as those claimed in said bill, and could not produce, and never did produce, a practically effective, satisfactorily working, or commercially successful telephone; that speaking telephones arranged and constructed in the manner mentioned and set forth in said patent of Bell, No. 174,465, have never been put in use, are of no commercial value, and are, for practical purposes, without utility and inefficient and worthless;

That it denies that since the 1st day of February, in the year 1884, it has made, used, and furnished to others for use in the city of Philadelphia or elsewhere, electric speaking telephones constructed and adapted for the transmission of articulate speech by and according to the method described and claimed in said patent to Bell, No. 174,465, and embracing and embodying

in one integral organization the alleged inventions and improvements, or material and substantial parts thereof, described and claimed in said patents to Bell, No. 174,465 and No. 186,787 respectively; that, on the contrary, the telephones made, used, and sold by it have been made and constructed under letters patent of the United States issued and granted in conformity with law to Henry Clay, as the first and original inventor of said patented improvements, and by him duly assigned to it; to wit, May 8th, 1883, No. 277,112, for a new and useful improvement in telephones; July 3d, 1883, No. 280,351, for switch-board for telephones; July 3d, 1883, No. 280,451, for telephone call bell; July 3d, 1883, 280,580, for transmitter for telephone; November 6th, 1883, No. 288,017, for telephonic transmitter; that the devices and methods of operation set forth in these several letters patent are not similar to, but are wholly different from the devices described and claimed in the said letters patent of Bell, and are not violations or infringements of said letters patent, and do not embody or embrace the method, principle, operation, or construction therein or thereby set forth, described, and claimed;

That the two several letters patent in the said bill mentioned embrace numerically thirteen claims; that the bill does not indicate which of the several claims are infringed by the respondent; that as respects said patent, No. 174,465, the devices used by the respondent do not embody the method or apparatus described in said patent for transmitting vocal or other sounds telegraphically in manner and form as set forth in said patent; that as respects said letters patent, No. 186,787, the devices used by the respondent do not use the apparatus, arrangements, and combinations, as set forth in said patent, or in manner and form as set forth and claimed in said patent;

That the alleged inventions or discoveries described or claimed in the said letters patent of Bell, or the substantial and material parts thereof claimed as new and original, had, prior to the alleged invention or discovery thereof by Bell, been mentioned, described, or claimed in divers letters patent granted and issued

to divers persons, mentioning the persons, and mentioning, among others, letters patent of Great Britain, No. 1044, dated April 8th, 1870, to Cromwell Fleetwood Varley;

That the alleged invention or discovery mentioned, described or claimed in the said letters patent of Bell, No. 174,465, or the substantial and material parts thereof claimed as new and original, had, prior to the supposed invention or discovery thereof by Bell, been made known, mentioned, and described in divers printed publications, setting forth the names, pages, dates, and places of the publications;

That the said respective letters patent of Bell are null and void for the reason, among others, that the principle or nature of said alleged invention is not fully, adequately, or intelligently explained so as to distinguish it from other inventions; that the part, improvement, and combination claimed by Bell is not particularly pointed out or distinctly claimed; that the specifications do not clearly and intelligently distinguish between the prior state of the art, the things theretofore known and in use, and the things claimed in said specification; that many of the combinations claimed in said patents are unpatentable as combinations; that many of said claims are vague, ambiguous, uncertain, and indefinite, and others of said claims are unlawful attempts to appropriate broadly, unrestrictedly, and exclusively the application and employment of principles of science, and the operation of laws or of properties of magnetic or electric action, which said attempted appropriation is unpatentable; that the said alleged inventions or discoveries have been in public use and on sale in this country for more than two years prior to the application of Bell, and the material and substantial parts thereof claimed as new and original have been abandoned to the public prior to said application;

That the distinction or difference asserted in the patents of Bell between undulatory currents and interrupted or pulsatory currents is imaginary, unreal, has no actual existence, and constitutes no patentable foundation of novelty, and furnishes no legal or equitable ground of distinction between the alleged

principle of the alleged invention or discovery of Bell, as claimed in said patents, and the methods and principles of action and operation well known and used in similar or analogous devices prior thereto.

The joint and several answer of the defendants John C. Scott, James McMillan, George W. Bratton, Samuel P. Godwin, John T. Bailey, John Marston, Jr., Thomas C. Else, James McC. Creighton, and Joseph Wright sets forth that these defendants are directors and officers of the Clay Commercial Telephone Company; that they are not parties or privies to the alleged acts of the said the Clay Commercial Telephone Company otherwise than as directors and officers of said company; and that they have not by themselves jointly, or jointly with the said Clay Commercial Telephone Company, made, used, furnished for use or sold electric speaking telephones.

The several answer of the defendant W. Harrison Godwin sets forth: that this defendant is employed by the Clay Commercial Telephone Company as its secretary; that his duties as such are merely clerical; and that he is not otherwise a participant in the acts or business of said company.

The several answer of the defendant Henry Clay sets forth: that this defendant is not an officer or directer of the Clay Commercial Telephone Company; that he assigned to said company the letters patent of the United States mentioned in the answer of said company; that he is employed in the service of said company for the purpose of keeping the telephone instruments of the company in working order and repair; and that he is not responsible for the acts and proceedings of said company.

The several answer of the defendant Alonzo P. Douglass sets forth: that this defendant is an attorney-at-law, and engaged in the practice of his profession; that as a member of the bar he has transacted matters of legal business for the Clay Commercial

Telephone Company; and that the only relation existing between himself and said company is the professional relation of counsel and client.

The complainants filed a replication to the several answers of the defendants.

COMPLAINANTS' EVIDENCE.

Four witnesses were examined on behalf of the complainants.

The depositions of Daniel M. Adee and William C. Tompkins related to the fact that the Clay Commercial Telephone Company was using electric speaking telephones and carrying on the business of telephony in the city of Philadelphia. This fact is not denied on the part of said company.

The deposition of Charles Eustis Hubbard related to the organization of the Bell Telephone Company of Massachusetts and other companies, and to the title to the patents of Bell.

The deposition of Professor Charles R. Cross related to electricity, telephony, the construction and operation of the instruments, and the scientific questions involved in the issue.

Documentary evidence was also offered on behalf of complainants.

From the evidence offered on behalf of complainants, it was shown:

That February 14th, 1876, Alexander Graham Bell made application to the Commissioner of Patents of the United States, and letters patent were issued to him, No. 174,465, dated March 7th, 1876, for certain new and useful improvements in telegraphy. (Record, pp. 57–65.)

That on December 9th, 1876, letters patent No. 4765, for improvements in electric telephony and telephonic apparatus, were granted in London, in the Kingdom of Great Britain, to William Morgan Brown, for and on behalf of Bell. (Record, p. 224–262.)

That on January 15th, 1877, Bell made an application to the

Commissioner of Patents of the United States, and letters patent were issued to him, No. 186,787, dated January 30th, 1877, for certain new and useful improvements in electric telegraphy. (Record, p. 67–75.)

That afterward, Bell assigned to Gardiner G. Hubbard and Thomas Sanders each an equal third part of the said two patents, dated respectively March 7th, 1876, and January 30th, 1877, so that the said Bell, Hubbard, and Sanders owned the said inventions and patents in equal third parts. (See testimony of Charles Eustis Hubbard, cross-int. 24, Record, p. 105.)

That on July 9th, 1877, Bell made and executed an assignment, whereby he assigned to Gardiner G. Hubbard, trustee, all the RIGHT, TITLE, AND INTEREST he (Bell) had in the inventions secured to him by the said two letters patent dated respectively March 7th, 1876, and January 30th, 1877, for, to, and in the United States and Territories, and in no other place or places. (Record, p. 76.)

That on July 9th, 1877, the said Gardiner G. Hubbard, trustee, executed a declaration of trust, providing for the formation of an association for the purpose of carrying on the business of telephony, to be called Bell Telephone Company, and declaring that he held the said letters patent in trust for the benefit of said company. (Record, p. 83–88.)

That an unincorporated association was formed by Bell and six others, the interests being divided into five thousand shares, which association carried on business with Gardiner G. Hubbard as its trustee. (See testimony of Charles Eustis Hubbard, int. 6, Record, p. 98; int. 9, Record, p. 99; int. 10, Record, p. 100; cross-int. 26, Record, p. 105; cross-int. 30, Record, p. 102.)

That the New England Telephone Company was incorporated to carry on the telephone business in New England, under license from Gardiner G. Hubbard, trustee. (See testimony of Charles Eustis Hubbard, cross-int. 30; Record, p. 106.)

That a company called the Bell Telephone Company was incorporated under the laws of Massachusetts to carry on business

for the whole of the United States outside of New England. (See testimony of Charles Eustis Hubbard, int. 9, Record, p. 100; cross-int. 30, Record, p. 106.) The charter of this company was not produced or offered in evidence, but the date of its incorporation appears to have been some time subsequent to July 19th, 1878.

That on July 20th, 1878, Gardiner G. Hubbard, trustee, executed an assignment, dated July 20th, 1878, assigning to the said Bell Telephone Company all the right, title, and interest held by him (Hubbard) as trustee of the said letters patent dated March 7th, 1876, and January 30th, 1877. (Record, p. 77.)

That on March 10th, 1879, the National Bell Telephone Company was organized. The Bell Telephone Company and the New England Telephone Company were merged in the National Bell Telephone Company, but the corporate existence of the Bell Telephone Company and New England Telephone Company has never ceased. (See testimony of Charles Eustis Hubbard, cross-int. 30, Record, p. 106.) There was no charter for either of these companies produced or offered in evidence.

That on March 19th, 1880, an Act of the Legislature of the Commonwealth of Massachusetts was approved, entitled "An Act to Incorporate the American Bell Telephone Company," wherein it was enacted that Alexander Graham Bell, William H. Forbes, George Z. Silsbee, Richard S. Fay, Alexander Cochrane, George L. Bradley, Francis Blake, Jr., Thomas Sanders, and their associates may associate themselves, and organize a corporation according to the provisions of Chapter 224 of the Acts of the year 1870, and the Acts in amendment thereof and in addition thereto, for the purpose of manufacturing, owning, selling, using, and licensing others to use, electric speaking telephones, etc., with a capital stock exceeding one million of dollars and not exceeding ten millions of dollars, but the act specifies no name for the corporation. (Record, p. 79.)

That on April 17th, 1880, the Secretary of the Commonwealth of Massachusetts issued a certificate under the seal of the Commonwealth of Massachusetts, certifying that W. H. Forbes, G.

L. Bradley, G. Z. Silsbee, C. E. Hubbard, F. Blake, W. G. Saltonstall, R. S. Fay, R. W. Devonshire, C. Emerson, T. B. Bailey, and C. M. Whitcomb have associated themselves with the intention of forming a corporation under the name of the American Bell Telephone Company, for the purpose of manufacturing, owning, selling, using, and licensing others to use electric speaking telephones, with a capital of seven million three hundred and fifty thousand dollars. (Record, p. 82.)

That on May 8th, 1880, the National Bell Telephone Company assigned and transferred to the American Bell Telephone Company all the right, title, and interest which it had to or under said two patents dated March 7th, 1876, and January 30th, 1877. (Record, p. 88.)

That on June 21st, 1880, Thomas Sanders executed an assignment, assigning to the American Bell Telephone Company all his right, title, and interest in and to the said patent, dated March 7th, 1876, No. 474,465. (Record, p. 539.)

This assignment was offered and received in evidence after the case had been argued.

That on June 22d, 1880, the Bell Telephone Company executed an assignment, assigning to the American Bell Telephone Company the exclusive right, under the patents dated March 7th, 1876, and January 30th, 1877, to all the territory in the United States except the State of Massachusetts. (Record, p. 78.)

That on April 23d, 1881, the Bell Telephone Company of Massachusetts executed an assignment, assigning to the American Bell Telephone Company the exclusive right, under the patents dated March 7th, 1876, and January 30th, 1877, to the State of Massachusetts. (Record, p. 538.)

This assignment was offered in evidence after the case had been argued.

That the transmitting and receiving instruments made and used by the defendants under the letters patent owned by the Clay Commercial Telephone Company differed in form, arrangement, and construction from those claimed by the

complainants according to the specifications and claims set forth in the said two letters patent dated March 7th, 1876, and January 30th 1877. (See testimony of Charles R. Cross, Record, pp. 144–155.)

DEFENDANTS' EVIDENCE.

Two witnesses, Dr. Carl Seiler and Dr. Charles M. Cresson, were examined on behalf of the defendants. Their testimony related to sound, telephony, the construction and operation of the instruments, and the scientific questions involved in the issue.

Documentary evidence was also offered on behalf of the defendants.

FINAL HEARING.

At the final hearing on the merits, and after the oral argument of defendants' counsel, the complainants offered in evidence:

The original and certified copy of a deed from the Bell Telephone Company of Massachusetts, dated April 23d, 1881, assigning to the American Bell Telephone Company the exclusive right, under the patents dated March 7th, 1876, and January 30th, 1877, to the State of Massachusetts.

Also, a deed from Thomas Sanders to the American Bell Telephone Company, dated June 21st, 1880, assigning to the American Bell Telephone Company all his right, title, and interest in and to the said letters patent dated March 7th, 1876, No. 174,465.

Also, the affidavit of George L. Roberts. (Record, p. 537.)

To this offer the defendants objected. The court overruled the objection, and admitted the evidence. The defendants excepted; and, with the leave and by direction of the court, filed their objection and exceptions of record. (Record, pp. 543–547.)

II.

ASSIGNMENTS OF ERROR.

1. The court below erred in entering a decree in favor of the complainants, when the evidence does not show that the American Bell Telephone Company was or is a corporation duly established under the laws of the Commonwealth of Massachusetts.

2. The court below erred in entering a decree in favor of the complainants when there was no evidence to show that the Bell Telephone Company of Philadelphia was or is a corporation duly established under the laws of the State of Pennsylvania.

3. The court below erred in overruling the objection of the defendants to the admission of the original and certified copy of the deed of assignment of the Bell Telephone Company of Massachusetts, dated April 23d, 1881, and the assignment of Thomas Sanders to the American Bell Telephone Company, dated June 21st, 1880, and the affidavit of George L. Roberts, offered in evidence by the complainants at the final hearing on the merits, and after the oral argument of the defendants' counsel.

4. The court below erred in entering a decree in favor of the complainants when the evidence shows that the complainants were not alone entitled to institute and maintain a suit against the defendants.

5. The court below erred in adjudging and decreeing that the title to the said several letters patent granted to Alexander Graham Bell, dated March 7th, 1876, No. 174,465, and dated January 30th, 1877, No. 186,787, is vested in the complainants, the American Bell Telephone Company.

6. The court below erred in adjudging and decreeing that the

said Alexander Graham Bell was the original and first inventor of the inventions described in the said letters patent dated March 7th, 1876, No. 174,465.

7. The court below erred in adjudging and decreeing that the said letters patent granted to Alexander Graham Bell for an improvement in telegraphy, dated March 7th, 1876, No. 174,465, are good and valid in law.

8. The court below erred in adjudging and decreeing that the defendants, the Clay Commercial Telephone Company, John C. Scott, James McMillan, George W. Bratton, Samuel P. Godwin, Henry Clay, John J. Bailey, John Marston, Jr., Thomas C. Else, James McC. Creighton, and Joseph Wright, have infringed the fifth claim of the said letters patent, dated March 7th, 1876, No. 174,465.

9. The court below erred in adjudging and decreeing that the said Alexander Graham Bell was the original and first inventor of the inventions described in the said letters patent, dated January 30th, 1877, No. 186,787.

10. The court below erred in adjudging and decreeing that the said letters patent granted to Alexander Graham Bell for an improvement in electric telegraphy, dated January 30th, 1877, No. 186,787, are good and valid in law.

11. The court below erred in adjudging and decreeing that the defendants, the Clay Commercial Telephone Company, John C. Scott, James McMillan, George W. Bratton, Samuel P. Godwin, Henry Clay, John J. Bailey, John Marston, Jr., Thomas C. Else, James McC. Creighton, and Joseph Wright, have in-

fringed the third, fifth, sixth, seventh, and eighth claims of said letters patent, dated January 30th, 1877, No. 186,787.

12. The court below erred in entering a decree against the appellants, John C. Scott, James McMillan, George W. Bratton, Samuel P. Godwin, John J. Bailey, John Marston, Jr., Thomas C. Else, James McC. Creighton, and Joseph Wright.

13. The court below erred in entering a decree against the appellant, Henry Clay.

14. The court below erred in entering a judgment and decree against the appellants, under the evidence.

III.

BRIEF OF ARGUMENT.

1.

It is alleged in the bill of complaint that the American Bell Telephone is "a corporation duly established under the laws of the Commonwealth of Massachusetts." This is a descriptive allegation. If a descriptive allegation is not proved as laid, it is a fatal variance.

(1 Greenleaf on Evidence, p. 82, sec. 64.)

To prove the incorporation, the complainants offered in evidence a special Act of the Legislature of the Commonwealth of Massachusetts. (Record, p. 79.) It is entitled "An Act to Incorporate the American Bell Telephone Company." The name of the proposed corporation is not mentioned in the body of the act.

"When a corporation is erected, a name must be given to it, and by that name alone it must sue and be sued, and do all legal acts. Such name is the very being of its constitution. The name is the very knot of the combination, without which it could not perform its corporate functions."

Blackstone's Commentaries, Book I, ch. 18, p. 476.
Angell and Ames on Corporations (10 ed.) sec. 1.
Dartmouth College *v.* Woodward, 4 Wheaton, 636.

The act is entitled, "An Act to Incorporate the American Bell Telephone Company." The title cannot confer the name American Bell Telephone Company upon the corporation.

"The title of a statute, it has been repeatedly held, is no part or parcel of the statute."

Potter's Dwarris on Statutes and Constitutions, p. 102.
Sedgwick on Construction of Statutes (2d ed.), pp. 39, 40.
Mills *v.* Wilkins, 6 Modern, 62.
Haddon *v.* The Collector, 5 Wallace, 107.
Coal Company *v.* Slifer, 53 Penna. 71.
Union Passenger Railway Company's Appeal, 32 P. F. Smith (Penna.) 94.

The special act, offered in evidence, enacts that Bell and his associates may associate themselves, and "organize a corporation according to the provisions of chapter 224 of the act of the year 1870, and the acts in amendment thereof and in addition thereto." Chapter 224 of the Act of 1870 and its amendments are now known as chapter 106 of the Public Statutes of Massachusetts, and so much thereof as relates to the association and organization of corporations is as follows:

Section 4. Any such number of persons as is hereinafter provided, who associate themselves together by such an agreement in writing as is hereinafter described, with the intention of forming a corporation for any purpose hereinafter specified, upon complying with the provisions of section 21, shall be and remain a corporation.

Section 16. Such agreement shall set forth the fact that the subscribers thereto associate themselves together with the intention of forming a corporation, the corporate name assumed, the purpose for which it is formed, the town or city, which shall be in this Commonwealth, in which it is established or located, the amount of the capital stock, and the par value and number of its shares.

Section 17. Any corporate name may be assumed which indicates that it is a corporation, and which is not in use by an existing corporation or company; and the name assumed shall be changed only by act of the General Court. If organized for the purposes mentioned in sections 9 or 10, the words "co-operative" or "fishing," respectively, shall form part of the name.

Section 18. The first meeting shall be called by a notice signed by one or more of the subscribers to such agreement, stating the time, place, and purpose of the meeting, a copy of which notice shall, seven days at least before the day appointed for the meeting, be given to each subscriber, or left at his usual place of

business or place of residence, or deposited in the post office, post-paid, and addressed to him at his usual place of business or of residence, and whoever gives such notice shall make affidavit of his doings, which shall be recorded in the records of the corporation.

Section 20. At such first meeting, including any necessary or reasonable adjournment, an organization shall be effected by the choice by ballot of a temporary clerk, who shall be sworn, and by the adoption of by-laws, and the election, in the manner provided in section 24, of directors, treasurer, clerk, and such other officers as the by-laws may provide; but at such first meeting no person shall be eligible as a director who has not subscribed the agreement of association. The temporary clerk shall make and attest a record of the proceedings until the clerk has been chosen and sworn, including a record of such choice and qualification.

Section 21. The president, treasurer, and a majority of the directors shall forthwith make, sign, and swear to a certificate setting forth a true copy of the agreement of association, with the names of the subscribers thereto, the date of the first meeting, and the successive adjournments thereof, if any, and shall submit such certificate and also the records of the corporation to the Commissioner of Corporations, who shall examine the same, and who may require such other evidence as to the facts of the case as he may judge necessary. The Commissioner, if it appears that the requirements of the preceding sections preliminary to the establishment of the corporation have been complied with, shall certify that fact and his approval of the certificate by indorsement thereon. Such certificate shall thereupon be filed by said officers in the office of the Secretary of the Commonwealth, who, upon payment of the fee hereinafter provided, shall cause the same, with the indorsement thereon, to be recorded, and shall thereupon issue a certificate in the following form:

The Secretary shall sign the same and cause the seal of the Commonwealth to be thereto affixed, and such certificate shall have the force and effect of a special charter, and shall be conclusive evidence of the existence of such corporation. He shall also cause a record of such certificate to be made, and a certified copy of such record may be given in evidence with like effect as the original certificate.

To further prove the incorporation, the complainants offered

in evidence a certificate, under the seal of the Secretary of the Commonwealth of Massachusetts, certifying that W. H. Forbes and ten other persons had associated themselves under the name American Bell Telephone Company, with a capital of seven million three hundred and fifty thousand dollars. (Record p. 82.)

The special act does not give the persons named in it power to assume a name. It gives them power to *organize* a corporation. The assumption of a name was not one of the incidents which attached, even by implication, to the powers, purposes, or objects stated in the act. We are to look at what the Legislature actually did, and not what it intended to do. The act was a grant from a sovereign power, and is to be taken most beneficially for the sovereign, and against the grantee.

2 Blackstone's Commentaries, 347.
Potter's Dwarris on Statutes, etc., p. 146, 215.
Dartmouth College *v.* Woodward, 4 Wheaton, 636.
Commonwealth *v.* Railroad Company, 3 Casey (Penna.), 351.

The special act was a later one. It does not incorporate chapter 224 in its provisions. It refers to chapter 224, by enacting that Bell and his associates might "organize a corporation according to the provisions of chapter 224." The powers conferred by the special act are limited to the precise language used. The language confers no authority upon the Secretary of the Commonwealth to issue such a certificate as has been offered in evidence.

Commonwealth *v.* Railway Company, 2 P. F. Smith (Penna.), 52.
Bowling Green Railway Company *v.* Warren County Court, 10 Bush (Ky.), 711.
Ellis *v.* Paige, 1 Pickering, 43.
Farmers' Loan Company *v.* Carroll, 5 Barbour, 613.
Angell and Ames on Corporations, secs. 81, 111.

2.

The Bell Telephone Company of Philadelphia is one of the complainants mentioned in the bill of complaint. It is described as "a corporation duly established under the laws of the State of Pennsylvania." Although, under the pleadings, the complainants were bound to prove the existence of the corporation, yet there was no act, law, charter, or evidence offered to prove that such a corporation ever did exist.

3.

At the final hearing on the merits, and after argument by defendants' counsel, the complainants offered in evidence an assignment from the Bell Telephone Company of Massachusetts to the American Bell Telephone Company, of all its right, title, and interest in the two letters patent, No. 174,465 and No. 186,787; and also an assignment from Thomas Sanders to the American Bell Telephone Company, of all his right, title, and interest in the letters patent No. 174,465, together with an affidavit of George L. Roberts. (Record, p. 537.)

The assignment from the Bell Telephone Company recites other agreements that are a part of the chain of title. The counsel for defendants objected to the reception of the evidence at that stage of the case, and as a part of the objection called for the agreements mentioned in the assignment. (Record, p. 544.)

The evidence was a material part of the complainants' chain of title, and should have been produced before the examiner, with the agreements mentioned therein, and proper proof made of the execution thereof. The court should have referred the evidence to an examiner.

4.

The evidence shows that the complainants were not alone entitled to institute and maintain a suit against the defendants.

The patents of 1876 and 1877 were granted to Bell.

Bell afterward assigned to Gardiner G. Hubbard and Thomas Sanders each a third of the title and interest in the patents. (Record, p. 105.)

Bell afterwards assigned his third interest to Gardiner G. Hubbard, as trustee.

Then the Bell Telephone Company, an unincorporated association, was formed and carried on business, with Hubbard as its trustee. (Record, pp. 98, 99,100, 103, 105.)

Then the New England Telephone Company was incorporated and received a license from Hubbard, the trustee. (Record, p. 106.)

Then Hubbard, the trustee, assigned to the Bell Telephone Company of Massachusetts all his right, title, and interest in the patents held by him in trust. (Record, p. 77.) This assignment appears to have been made before the Bell Telephone Company was organized or incorporated. (Record, p. 100.)

Then the Bell Telephone Company is alleged to have been incorporated under the laws of the Commonwealth of Massachusetts "to carry on business for the whole of the United States outside of New England." (Record, p. 106.) As Massachusetts is included in the New England States, the Bell Telephone Company was prohibited by its charter (if it had one) from carrying on business in Massachusetts, under whose laws it was incorporated. Therefore, the company should be regarded not as a corporation, but merely as a partnership.

"No rule of comity will allow one State to spawn corporations and send them forth in other States to be nurtured and do business there when said first-mentioned State will not allow them

to do business within its own boundaries." (Land Grant Railway and Trust Company *v.* Commissioners of Coffee County, 6 Kansas, 245).

Hill *v.* Beach, 1 Beasley (N. J.), 31.

Then the National Bell Telephone Company was organized. (Record, p. 106.) There was no charter produced for this company, but it appears that the Bell Telephone Company and the New England Telephone Company were merged in the National Bell Telephone Company, yet the corporate existence of the Bell Telephone Company and the New England Telephone Company has never ceased. (Record, p. 106.)

Then the American Bell Telephone Company is alleged to have been incorporated. If it were not properly incorporated, it also should be regarded merely as a partnership.

Then the National Bell Telephone Company assigned to the American Bell Telephone Company all its right, title, and interest in the two patents. (Record, p. 85.) It does not appear how the National Bell Telephone Company acquired any right, title, or interest in the two patents, except by inference, from the testimony as to the merger in that company of the Bell Telephone Company and the New England Telephone Company, together with the recitals in the various assignments, of agreements existing between the three companies.

Then Thomas Sanders assigned to the American Bell Telephone Company all his right, title, and interest in the patent, dated March, 7th, 1876. (Record, p. 539.) Sanders still retained his third interest in patent of January 30th, 1877.

Then the Bell Telephone Company of Massachusetts assigned to the American Bell Telephone Company the exclusive right, under the two patents, to all the territory in the United States, except the State of Massachusetts. (Record, p. 76.)

Then the Bell Telephone Company of Massachusetts assigned to the American Bell Telephone Company the exclusive right, under the two patents, to the State of Massachusetts. (Record, p. 538.)

The facts here stated are shown by the evidence offered by the complainants in support of their right and title to bring suit. If the various assignments to the American Bell Telephone Company were made by parties lawfully and equitably authorized to make such assignments (which fact is not conceded, but, on the contrary, is shown by the evidence to be otherwise), the complainants' own evidence shows:

First. That, as regards the patent dated March 7th, 1876, No. 174,465, at the time this suit was brought, the American Bell Telephone Company owned two-thirds of said patent and Gardiner G. Hubbard owned the remaining one-third thereof.

Second. And that as regards the patent dated January 30th, 1877, No. 186,787, at the time this suit was brought, the American Bell Telephone Company owned one-third of said patent, Gardiner G. Hubbard owned one-third, and Thomas Sanders owned one-third thereof.

5.

The court below adjudged and decreed that the title to the two letters patent, dated respectively March 7th, 1876, and January 30th, 1877, is vested in the complainants, the American Bell Telephone Company.

This judgment and decree are erroneous, because the complainants' proofs show that the American Bell Telephone Company owned but TWO-THIRDS of the patent dated March 7th, 1876, and but ONE-THIRD of the patent dated January 30th, 1877.

6.

The sixth, seventh, and eighth assignments of error may be considered together.

The court adjudged and decreed that Bell was the original and first inventor of the inventions described in the patent dated March 7th, 1876, No. 174,465; that the title to the letters patent are good and valid in law, and that the appellants have infringed the fifth claim of the said letters patent.

Professor Cross, the only witness on the part of the complainants, was asked, upon cross-examination, to distinguish what, in his opinion, is new and what is old in the specifications in the patent. In his answer the witness pointed out what, in his opinion, was new. (Record, pp. 176, 177, and 178.) On page 178 the paragraph commencing with the words "In this specification," must not be included in the new matter, because, as the witness afterward testified (Record, p. 185), he included that paragraph in the new matter by mistake.

The evidence shows that Bell was not the original and first inventor of the inventions described in the patent.

The material parts of the invention, claimed as new and original, were made known and described in printed publications prior to the granting of the letters patent, which printed publications have been offered in evidence.

The substantial and material parts of the invention claimed were described and claimed in letters patent granted to other persons prior to the grant of the letters patent to Bell, and which letters patent have also been offered in evidence.

The claim is not warranted by the descriptions and specifications set forth in the patent or by the proofs and evidence.

The apparatus is inherently unfit for telephonic purposes in the transmission of articulate speech. (Testimony of Dr. Cresson, Record, pp. 368, 370.)

That the letters patent dated March 7th, 1876, are not good and valid in law.

That the letters patent dated January 30th, 1877, are not good and valid in law.

The evidence also shows that the instruments used by the Clay Commercial Telephone Company are not formed, arranged, or constructed in conformity with or according to the specifications and claims set forth in the Bell patents, and that the defendants had not infringed the said patents of Bell. (Testimony of Professor Cross, Record, p. 144–155; testimony of Dr. Cresson, Record, p. 382–385.)

WILLIAM W. KER,

of Counsel for Appellants.

Office Supreme Court U. S.
FILED
JAN 22 1887
JAMES H. McKENNEY
CLERK.

Supreme Court of the United States.

No. 1092.

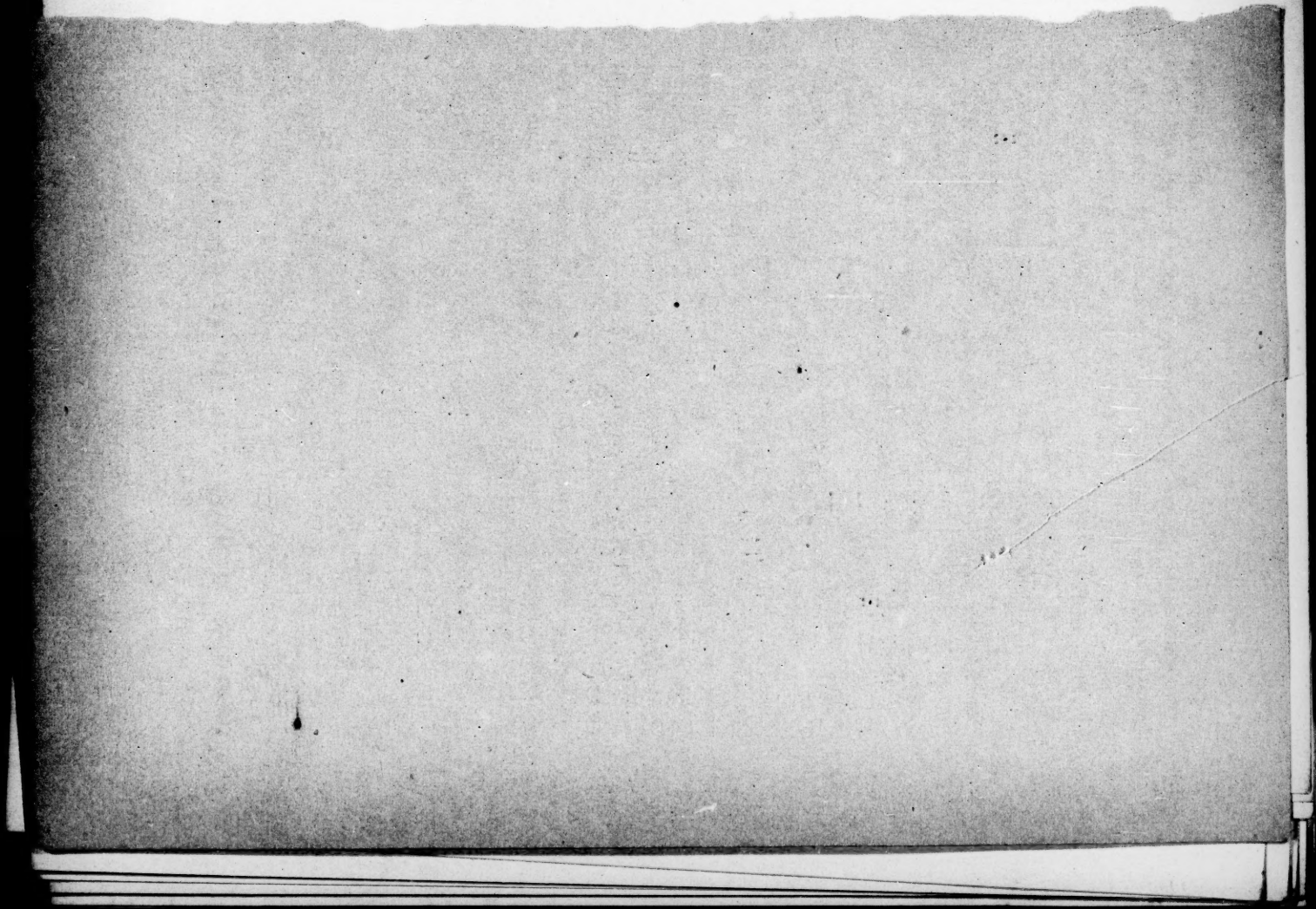
CLAY COMMERCIAL TELEPHONE CO. ET AL.

APPELLANTS,

v.

AMERICAN BELL TELEPHONE CO. ET AL.

BRIEF FOR APPELLEES.



Supreme Court of the United States,

OCTOBER TERM, 1886.

CLAY COMMERCIAL TELEPHONE CO. ET AL.
v.
AMERICAN BELL TELEPHONE CO. ET AL. } No. 1092.

SPECIAL BRIEF FOR THE BELL COMPANY, APPELLEES.

The Clay Company's brief raises two special questions. The facts on which they must turn are in all the cases, but no counsel in any of the litigation, either before or since the Clay case, has thought them worth raising. They raise technical questions about the legal title of the Bell Company to the patents under which all its business has always been done, and questions as to the effect of Mr. Bell's English patent on the validity of his second subordinate United States patent. These objections cannot be raised in any other case, because they were not duly taken in the court below, where they could have been remedied if there were any foundation for them. For the same reason, the questions are not open in *this* case.

Title. The chain of title alleged in the bill (*Clay*, p. 5 paragraph 3) is:

Grant to Alexander Graham Bell:

Recorded assignment, dated July 28, 1877, to Gardiner G. Hubbard, trustee.

Assignment, Hubbard, trustee, to Bell Telephone Company, by deed dated July 20, 1878, recorded Oct. 3, 1878.

Assignment, Bell Company to American Bell Company (complainants), by deed dated June 22, 1880, recorded June 24, 1880, of the exclusive right and legal title to all the territory of the United States except the State of Massachusetts.

Another deed, same to same, dated April 23, 1881, of the exclusive right for the State of Massachusetts, and all other remaining title and rights.

These assignments were produced and duly proved. The substance of them is, that the patents were granted to Mr. Bell; that he assigned them to Hubbard, trustee; that Hubbard, trustee, assigned them to the Bell Company; that the Bell Company assigned them to the American Bell Company, first for the whole of the United States, except Massachusetts, and afterwards for Massachusetts.

The answer says that the defendants have no information about the incorporation of the corporations mentioned, nor about the transfers of title, and alleges "that the said alleged title, as set forth in said bill, does not authorize the complainants to bring or maintain this bill," and prays that the complainants be required to prove the grants referred to.

In putting in the testimony, the complainants' counsel put in all the deeds referred to, with one exception. He forgot to put in the second deed from the Bell Company to the American Bell Company, conveying the interest for the territory of Massachusetts. That was not material, because the infringement complained of took place entirely in Pennsylvania, and under the statute, the American Bell Company, owning the territorial title for Pennsylvania, could bring the suit whether it owned the patent for Massachusetts or not. The omission was not noticed on either side until the argument. Then the Court, upon the suggestion of the complainants, allowed the deed in question and some others to be put in, together with the affidavit of Mr. Roberts, the counsel who put in the evidence for the Bell Company, that he either did not know of, or had overlooked the deed in question (*Clay*, 537–541).

It was specifically alleged in the bill, and was put in evidence in other cases where other counsel took the *prima facie* case. The record without that deed, and of course the record with it, makes a perfect legal title on the face of the papers in the American Bell Telephone Company. It is the title alleged in the bill which is sworn to by the president of the company. Neither the answer nor the evidence suggest any conveyance putting the legal title elsewhere.

To make technical proof of the signatures to the assignments and some other similar matters, the complainants called Mr. Charles Eustis Hubbard, who had been clerk of the corporations referred to.

He testified that the first deed, July, 1877, Bell to Hubbard trustee, was originally in his possession as clerk of the association for which Hubbard was trustee; that he sent it to the Patent Office and had it recorded; and adds: "To the best of my recollection, they were returned to me from Washington, and were in my custody as clerk of the association; but though I have made diligent search for them in various places, I have been unable to find them, and do not know where they are." The assignment was to Hubbard, as trustee for the *Bell Telephone Association*. The witness was their lawful custodian, and their actual custodian. He had lost them and had searched for them. He was cross-examined as to when he last saw them; the removals of his office; the search he had made in his present office and in the vault where he formerly kept his papers, and at the house of Mr. Gardiner G. Hubbard among papers of Mr. Hubbard and Mr. Bell. That proved the existence, execution and loss of the papers by the witness whose special duty it was to have them, and who is last known to have had them in his custody. We then proved the paper by an exemplified copy from the Patent Office, Mr. Hubbard swearing to the fact that he has also compared the exemplified copy with another copy which he had himself prepared from the original. No objection was made that the loss was not duly proved. If there had been, other witnesses could have been examined if necessary. No such objection can now be made.

On cross-examination he testified as to various business relations of certain companies; upon which the defendant, on the record (*Clay*, 107) called for the production of an agreement between the Bell Company and the National Bell Company, and between the National Bell Company and the American Bell Company, apparently on the assumption that that might show some title in the National Bell Company. The complainants declined to produce the papers, on the ground that they were "merely collateral and did not affect the legal title to the patents in suit"; but they thereupon put in evidence a legal assignment of all right, title and interest, from the National Bell Company to the Bell Company, made and recorded in 1880, several years before the suit was brought, and proved its execution by the officers and board of the corporation. That com

pany appears to have had some equitable or collateral interest under a contract, but, whatever it had, the deed evidently closed the question.

The Clay Company's counsel cross-examined Mr. Hubbard with relation to Mr. Thomas Sanders. The testimony was (*Clay*, 105):

"*Cross-Int.* 23. What relation had Mr. Sanders with Mr. Bell?

"*Ans.* Mr. Sanders and Gardiner G. Hubbard furnished the means to enable Mr. Bell to pursue his experiments and work in telephonic and telegraphic invention.

"*Cross-Int.* 24. What was Mr. Bell's interest in the association?

"*Ans.* Mr. Bell, Mr. Hubbard, and Mr. Sanders owned the inventions and patents in equal third parts. The majority of Mr. Bell's interest in the association was, in accordance with a previous arrangement, given to his wife, Mabel G. Bell.

"*Cross-Int.* 25. Were these one-third interests held by the three persons whom you have named, severally or jointly?

"*Ans.* They were held jointly, until they took the form of shares in this association. Then they were divided according to the respective interests. This was Aug. 1, 1877.

"*Cross-Int.* 26. Please give me the allotment of shares made at that time.

"*Ans.*

Mabel G. Bell	1,497
Alexander Graham Bell	10
Thomas A. Watson	499
Thomas Sanders	1,497
Gertrude McC. Hubbard	100
Gardiner G. Hubbard	1,387
Charles Eustis Hubbard	10
	5,000 "

That is a statement, not that Mr. Sanders had any *legal* interest in the *patents*, but that he had an equitable interest, *represented by shares in the association*. At the argument, the Clay Company insisted that Mr. Hubbard's statements on cross-examination legally proved that Mr. Sanders had a legal interest in the patents; and, therefore, the Bell Company only owned two thirds of them, to which several replies were made:

First. That no suggestion of that sort was made in the answer or the testimony, and the testimony referred to only showed an *equitable* interest in the *association*, which held an *equitable* interest under the deed of the entire *legal* title to Hubbard as trustee for them:

Second. That the assignment of that legal title by Hubbard, Trustee, to the Bell Telephone Company was made in pursuance of a vote of the association, in favor of which there voted every one present at the meeting, to wit, the owners of 4,990 out of 5,000 shares, the only person absent being Mr. A. G. Bell; *that Mr. Sanders was present, voted that the transfer should be made, and himself moved the vote directing the trustee to make the assignment.* That of course vested the *legal* title which is all that is material, and cut off any possible equities.

That there might be no possible question about the fact, the complainants then asked and obtained leave to prove and offered in evidence a release from Sanders to the American Bell Telephone Company of all his right, title, and interest in the patent, dated June 21, 1880. The Court allowed that for whatever it might be worth, saying, however, "the legal title all appears *here* [*i. e.* in the Bell Company] upon the record, so far as Mr. Sanders is concerned."

That these deeds, if necessary, could be proved as exhibits at the hearing is well settled. "Deeds, bonds . . . of which proof must be made of the handwriting of the persons writing or executing the same, are all considered as exhibits, and may be proved at the hearing." 2 Daniel's Chancery Practice, 5th edition, 882; *Nesmith* v. *Calvert*, 1 Wood & M. 34; *Dale* v. *Roosevelt*, 6 Johns Ch. 255; *Sloate* v. *Penim*, 4 Sim. 101, 110.

The objection was not well taken, because the objection that other parties ought to be plaintiffs, the plaintiff on the record having some aliquot part of the title, ought to be specifically taken by answer, pointing out who are the parties that ought to be joined, to the end that the complainant may join them. Story's Equity Pleadings, 238. 1 Daniel's Ch. Pr., 289; *Greenleaf* v. *Queen.* 1 Pet. 149.

Construction of the deed. The Clay Company also made the objection at the hearing, but never before, that the deed from Mr. Bell to Hubbard, trustee, of July, 1877, did not convey the patent. The language of the deed is, that whereas Mr. Bell obtained the patents, etc.

"I have assigned, sold and set over, and by these presents do assign, sell, and set over unto the said Gardiner G. Hubbard, trustee, all the right, title and interest I have in the above-described invention, as secured to me by Letters Patent, for, to, and in the United States and Territories, and in no other

place or places. The same to be held and enjoyed by the said Gardiner G. Hubbard, trustee, for his own use and behoof, and for the use and behoof of his legal representatives, to the full end of the term for which said Letters were granted, as fully and entirely as the same would have been held and enjoyed by me had this assignment and sale not been made."

The objection taken was that it was an assignment of all Mr. Bell's right, title and interest, and did not in terms assert that he had any.

His assertion that he had a title would not affect the question whether he had. If he had one he conveyed it; if he had not, his false assertion would not have helped it. It so happens, however, that the language of this deed is copied from some deeds which have been construed by this Court as conveying a good legal title to a patent, *Railroad* v. *Trimble*, 10 Wall. 368, 379, approved and followed in *Hendrie* v. *Sayles*, 98 U. S. 553. Precisely this language was there held to convey the title to the patents.

INCORPORATION OF THE AMERICAN BELL TELEPHONE COMPANY.

The Clay Company object that it does not appear that the complainant's corporation, the American Bell Telephone Company, was incorporated. The evidence consists of a duly certified special act of the Legislature of Massachusetts, authorizing Messrs. Bell, Forbes, Sanders, and others named, to organize themselves into a corporation, under the general laws of Massachusetts, for the purpose of making and using telephones and carrying on business under telephonic patents, etc., with a capital of $10,000,000, and with the rights given by the General Statutes of Massachusetts. The General Statutes authorized persons to organize themselves into a corporation for manufacturing and other similar purposes, and for the transmission of intelligence by electricity, but it limited the capital to $1,000,000. This special act authorized these persons to organize under the same general laws, and increased the limit in their case to $10,000,000, and specified some additional powers. It was, in effect, *pro tanto* an amendment of the general law. This is followed by a certificate under the statute by the Secretary of the Commonwealth of Massachusetts, under the broad seal, stating that the organization papers were duly executed and lodged in the office, and further stat-

ing that, under the statute of Massachusetts, such a certificate under the seal of the State is *conclusive evidence of the organization*, having "the force and effect of a special charter."

The objection taken is, that the corporation has no name, and has no right to assume "*American Bell Telephone Company*" as its name; and the ground is, that the Act does not say that such shall or may be its name. To this there are two answers:

First. The general law under which they are to become associated authorizes the incorporators to assume any name they see fit, and the certificate of the corporation says that they have associated themselves to become, and are made, "an existing corporation under the name of the American Bell Telephone Company."

Second. Although the Act, *in its body*, does not in terms say that such *shall* be their name, it authorizes them to take any name they please, unless specially restrained, because such are the terms of the general law. The Act itself is entitled "*An Act to incorporate the American Bell Telephone Company.*" They certainly, therefore, had the right to take that name. They had no right to take any other.

The defendants cited an authority which they said determined that the title of the act is not part of the act. There is no such authority. The case referred to — *Hatton* v. *Collector*, 5 Wall., 110, — decided on the contrary that the title was part of the act; but, that if *explicit* statements in the body of the act contravened general conclusions which might be drawn from the mere phraseology of the title, the specific statements were to prevail. No such contradiction here exists.

The Clay Company also objected that the "Bell Telephone Company," one of the mesne assignees, was not proved to have been a corporation. No such objection was taken in the answer or on the record, and therefore it cannot be taken at the hearing. The bill alleged that one of the assignments was, "unto the Bell Telephone Company, a corporation under the laws of the Commonwealth of Massachusetts," and that that company assigned it unto the "American Bell Telephone Company," another corporation existing under the laws of Massachusetts. That latter company was a complainant; the "Bell Telephone Company" was not. The defendants' answer

said that it did not know whether the *complainant* was a corporation, but it did not expressly nor impliedly deny the incorporation of the intervening companies.

The only *testimony* on the subject is the statement in the deposition of Mr. Hubbard, clerk of the corporation. He was called as a witness and examined, with the minutes and records of the corporation in his hands. In one of his answers he said:

"The Bell Telephone Company, to whom the said Gardiner G. Hubbard, trustee, made an assignment dated July 20, 1878, and which made an assignment to the American Bell Telephone Company, dated June 22, 1880, is a legal corporation, fully incorporated under the laws of Massachusetts."

That is not the best possible evidence, but it is competent evidence until objected to, and as it was made by a clerk of the corporation, with the records in his hands, it is of course morally conclusive as to the fact.

Those deeds were then offered, and *the defendants who had not denied the incorporation in their answer here again made no objection either to the deeds themselves or to the minutes of the corporation, nor to the statement that it was a corporation.* If they had made the objection, a copy of the charter could have been produced. To omit to take the objection, is, therefore, to waive it. *Burton* v. *Driggs*, 20 Wall. 133; *Doane* v. *Glenn*, 21 Wall. 25. The charter is a public document, and they could have proved it.

It was objected that the "Bell Telephone Company of Philadelphia," a co-complainant had not sufficiently proved its title. That is of no consequence. The Bell Company owns the legal title and makes and furnishes to the Philadelphia Company all its instruments on a continuing yearly royalty. An infringement in Philadelphia is an injury to the American Bell Telephone Company, and will entitle it to nominal damages which was all that was here insisted on, an account being waived to facilitate an appeal.

It was objected that the American Bell Telephone Company was not licensed to carry on business in Pennsylvania under the Pennsylvania Statutes. It does not carry on business except in Massachusetts. This has recently been settled by Jackson J. in Ohio. There was no evidence in the Clay case tending to show the contrary.

Joinder of Defendants.

The bill alleged that the defendant corporation, and the individual defendants jointly infringed. The individual defendants answered that they had not *individually* made telephones, but were directors and officers of the defendant corporation. They admitted their participation in the infringing acts of the corporation as directors and managers, but said (in answers signed only by their counsel, and not by themselves, and not sworn to) that they did not know that they infringed. The repeated decisions, and the statements in their own patents and advertisements, however, showed that what they did was claimed by the Bell Company, and held by the Court to be an infringement.

The proof was, that the individual defendants formed a corporation for the purpose expressed in the articles, of buying Mr. Clay's patents for improvements in telephones, and making, furnishing, etc., "*Clay*" telephones, and for no other purpose (*Clay*, 189).

In an advertisement signed by the individual defendants as directors, etc., they say:

"The Board of Directors is composed of active and well-known business men of Philadelphia, *who have invested their money* in the enterprise, and *their names are sufficient guarantee that the business will be pushed with energy and vigor.*"

It was so "pushed."

The complainants have a right to an *injunction* against those who organized a corporation to infringe, became its managers, as such, "pushed" the infringement "with energy and vigor," in order to share the profits thereof, and advertised that they were doing so. It is not necessary to consider the question of responsibility for damages, because the decree was for a nominal sum only.

The Effect of the English Bell Patent on Bell's Second American Patent.

The first United States Patent, No. 174,465, was granted March 7, 1876. No application was filed in England for any patent whatever by Mr. Bell until December 9, 1876. The English patent granted on that application, therefore, cannot under the statute affect the

first and former patent: and it is not so pretended. The contention is, that the inventions of the *second* Bell patent, No. 186,787, of January 30, 1877, were covered by an English patent *granted before* the American patent, and therefore that the duration of the United States patent was limited to expire, either with the English patent or seventeen years from the granting of the English patent; and next, that as the Commissioner of Patents did not express that limitation on the face of the patent, it was *ipso facto void*.

To this, the *First* answer is, that if the law makes it to expire a certain time after the grant of the English patent, it will be dead after that time; but that time is far distant, and the patent is therefore alive. No statute makes it necessary for the Commissioner to *express* the limitation, and he cannot prolong the United States patent by failing to express it. His expression of it, or failure to express it, is of no legal value, and therefore in law immaterial.

Second, no such defence is taken in the Clay answer.

Third, the legal defence so taken depends on the allegation of fact contained in the Clay Company's brief, that the inventions were patented in England December 9, 1876, and patented in the United States January 30, 1877, and therefore that they were first patented in England. That is entirely untrue. The specification of the English patent was not filed in England until June 9, 1877, and therefore the patent did not issue until after that (*Clay*, 241).

The facts are, that a provisional specification, which in England is in the nature of a petition, was filed in the English Patent Office December 9, 1876. The United States Patent issued January 30, 1877. The *final* specification was filed in the Patent Office in England June 9, 1877, and the English patent did not exist, either in fact or in law, until then. In the annexed brief, which was used in the court below, we have shown by the united concurrence of all the United States authorities and by all the English authorities, that the invention is not "patented" in England until the specification is filed and the patent is issued. This Court decided that in *O'Reilly* v. *Morse*, and that rule has always been followed since.

The contention of the Clay Company is a sufficient demonstration of this. They insist that on January 30, 1877, the United States Commissioner of Patents should, in the Bell patent issued on that

day, have stated that the inventions were patented in England. No English patent existed at that time, and whether any one ever would exist would depend on a judicial determination of the English Patent Office authorities thereafter to be made, partly on a petition then pending and partly on a "complete" specification, which not only had not then been filed, but did not then exist.

We refer the court to the annexed brief for a full collection of all the facts and authorities, particularly for a fuller statement of the practice of the English patent law, as derived from a verified copy of all the proceedings in this case in the English Patent Office, than has ever been furnished in any litigation in this country; together with the English authorities as to the time when an invention becomes "patented," even under the English law.

E. N. DICKERSON.
CHAUNCEY SMITH.
J. J. STORROW.

Circuit Court of the United States.

EASTERN DISTRICT OF PENNSYLVANIA.

AMERICAN BELL TELEPHONE CO.

v.

THE CLAY COMMERCIAL TELEPHONE CO. ET AL.

SUPPLEMENTAL BRIEF FOR COMPLAINANTS ON FINAL HEARING.

Mr. Bell's second U. S. Patent, No. 186,787, of Jan. 30, 1877, is not destroyed by Morgan-Brown's English Patent 4,765 for inventions communicated to him by Mr. Bell.

E. N. DICKERSON,
C. SMITH,
G. L. ROBERTS,
C. HOWSON,
J. J. STORROW,
Of Counsel.

C. HOWSON,
Solicitor for Complainants.

BOSTON:
ALFRED MUDGE & SON, LAW PRINTERS, 24 FRANKLIN STREET.
1885.

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Circuit Court of the United States,

EASTERN DISTRICT OF PENNSYLVANIA.

IN EQUITY.

AMERICAN BELL TELEPHONE CO. ET AL.

v.

CLAY COMMERCIAL TELEPHONE CO. ET AL.

SUPPLEMENTAL BRIEF FOR COMPLAINANTS.

Does Morgan-Brown's English patent 4,765, on inventions communicated to him by Mr. Bell, have any effect on Mr. Bell's patent 186,787 of Jan. 30, 1877, for improvements in telephone apparatus?

This contention is confined to Mr. Bell's *second* patent, which is for mechanical improvements in the speaking telephone apparatus of his earlier patent, and does not touch his first patent.

The defendants in their answer aver among other things: —

"That substantial and material parts of the things described and claimed in the said Letters Patent of Jan. 30, 1877, No. 186,787, were described and claimed in prior foreign Letters Patent, taken out by and for the said Bell, and in his behalf, in the city of London, in England, which said last-mentioned foreign Letters Patent bear date on or about the ninth day of December, A. D. 1876; and that, inasmuch as said subsequent Letters Patent of the United States, numbered 186,787, do not bear even date with the said foreign Letters Patent, and are not limited to expire therewith; the said last-mentioned Letters Patent of the United States were and are therefore null and void."

The United States statute referred to is as follows: —

R. S. 4887. "No person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be de-

clared invalid by reason of its having been first patented, or caused to be patented, in a foreign country, unless the same has been introduced into public use in the United States for more than two years prior to the application. But every patent granted for an invention which has been previously patented in a foreign country shall be so limited as to expire at the same time with the foreign patent; or, if there be more than one, at the same time with the one having the shortest term, and in no case shall it be in force more than seventeen years."

It is not alleged that the English patent has expired. On the contrary, the answer assumes, and the fact is, that it will not expire until Dec. 9, 1890. It is not material for the purposes of this case whether Mr. Bell's second U. S. patent sued on expires Dec. 9, 1890, or seventeen years from Jan. 30, 1877. The ground taken by the answer is (and nothing short of this will make a defence) : —

1. That the case is within R. S. 4887.

2. That the meaning and effect of R. S. 4887 is that the U. S. Commissioner of Patents was bound to know and to express on the face of Mr. Bell's second U. S. patent before he signed it, on Jan. 30, 1877, the date when Mr. Bell's English patent would expire, and to declare that the U. S. patent expired on the day so named.

In other words, the inquiries are : —

1. Was any part of the invention patented by Mr. Bell's United States patent of Jan. 30, 1877 (to use the language of the statute) "*patented*" in a foreign country previous to the grant of the United States patent; that is, before Jan. 30, 1877?

2. Or, to use the language of the answer, chosen, we think, with acute legal skill to express exactly what the law requires the defendants to prove, was any part of that invention, or if so, what part, "*described and claimed*" in any English patent "taken out in his behalf" before Jan. 30, 1877?

If the first inquiry be answered in favor of the complainants, then the defence fails. If answered in favor of the defendants, then they must further establish that the failure to express on the face of the United States patent the expiration of such an English patent as the preceding inquiry calls for, makes the United States patent "null and void," *ab initio*.

This invokes another inquiry : —

3. Whether the United States Commissioner of Patents could, in fact, or by contemplation of law, know or learn on Jan. 30, 1877 — perhaps ask whether Mr. Bell could then inform him — whether any English patent touching the subject matter existed, and if so, how much of the invention of the United States patent of Jan. 30, 1877, such English patent covered, and when it would expire?

For if this could not be *known*, it could not be expressed on the face of the United States patent.

Upon these inquiries every reported decision in the United States is in favor of the complainants.

This case differs from any ever presented before, in very important features. For the first time, so far as we are aware, the Court called upon to consider the matter has before it full copies of all the records of the English Patent Office relating to the English patent, together with the English statutes under which the proceedings were taken, and the English decisions, explaining their meaning, and illustrating the course of procedure under them. These new *facts* put beyond the pale of discussion many matters which in former cases have been the subject of mere conjecture or argument, or have been entirely misapprehended, for want of this proper proof.

DATE WHEN MR. BELL'S SECOND IMPROVEMENTS, OR SOME OF THEM, WERE PATENTED IN ENGLAND BY PATENT 4,765, GRANTED TO WILLIAM MORGAN-BROWN, AS THAT DATE IS FIXED BY THE ENGLISH LAW AND COURSE OF PROCEDURE.

It was granted under the English statute of 1852 (15 and 16 Vict., c. 83). The proceedings, which were as prescribed by that act, are briefly and in substance as follows: —

A petition is filed (£5 stamps), accompanied (in the course adopted in this case and that usually followed) by a paper called the "provisional" specification (§ 6), which is required to set forth in general terms the general nature of the invention; but a full and technically sufficient description, with suitable claims, called the "complete" specification, must be filed at or shortly after the grant of the patent.

Under the old statute (21 Jac. I., c. 3), still in force (quoted p 8,

infra), any use or publication, even by the inventor himself, before his patent actually issued, would prevent it from issuing or destroy its validity. Act 1852 provides that if the proper officer finds the application proper in form and on its face, as an application, and so certifies and publicly advertises its pendency, the crown *may* thereafter, *if it sees fit*, grant the patent, notwithstanding some intermediate use or publication. But it does not always do so. (See p. 6 and p. 22, *infra*.) The proceedings in England had advanced to the point of this advertisement before the United States patent (of Jan. 30, 1877) issued, but the case had then gone no further.

After the United States patent issued, the English applicant took the next step, which is in effect a motion that a patent be granted ("notice of intention to proceed"), and upon this he paid a new fee of £5. This motion is advertised (Feb. 13, 1877). Thereupon the case went before the Attorney-General (March 8–12), and afterwards (May 15, 1877) before the Lord Chancellor. Any one is at liberty to oppose before either officer, and upon such hearing, evidence may be offered and counsel heard. If, on these hearings (some of those before the Chancellor are reported in the regular reports), the determination is favorable to the applicant, the patent is thereafter prepared, "*sealed*" and delivered to the patentee, who pays £10 more. Shortly thereafter the patentee, paying another £5, files for the first time a "complete specification" (June 9, 1877), which contains his "claims," and *this for the first time defines what is patented*. This is at once made public. All the papers, including the provisional specification, are kept secret up to that time.

Then and then only has it been determined whether the applicant shall have a patent or not, and what its scope shall be. The great seal is not merely the evidence of his right; *the affixing of the seal creates the right. The will of the sovereign is by the express terms of the statute, and according to the decisions kept in abeyance until that physical act is performed.* Then only does the invention become clothed with a monopoly. After that only can the party bring a suit. The monopoly did not exist before that. It was not before taht even determined whether it everwould exist, nor what its scope should be, nor when it should begin, norwhen expire. It will not

even retrospectively exist as of any instant before that. He can never complain of any use made of his invention before the day when his patent is sealed, — a day described in terms by the statute as the day when it is "*actually granted.*" Before that he is a suppliant; after it he is a monopolist. Up to that day he has not, nor is it determined that he ever will have, any rights as against the public.

Such are the express provisions of the statute, and the rules laid down by the English authorities in construing it.

"Provisional Protection" and "Antedating."

The theory of the English law is that a patent is a grant by the crown out of its royal prerogative. No statute has *required* the crown to grant a patent in any case; all that Parliament has done has been to forbid the exercise of this power in certain cases, and prescribe the forms for its exercise in others. The Statute of Monopolies (21 Jac. I., c. 3), forbidding many monopolies, left with the crown certain power with respect to manufactures new "at the time of *making* such Letters Patents and grants," and this statute, modified as presently to be stated, was in force in 1876–7. When a somewhat formal mode of procedure was adopted, one difficulty was that if the invention became known to the public between the day of the application and the day for the actual grant, no power remained in the crown to grant a valid patent.

To relieve the crown from this *lack of power*, the act of 1852 provided that as soon as an application with a provisional specification was filed, the proper officer, if he found it correct *as an application*, should so certify and publicly advertise its pendency. Where this had been done, the crown, if it should thereafter grant a patent, *might* also, if it should see fit, antedate it to the day of the application. If it should antedate it, which it was not obliged to do, and which, in fact, it has in many reported cases refused to do, the "validity and force" of the patent should be determined as if it had been actually granted on that day. But no other effect follows, for by the express terms of the act, the monopoly shall only exist from the day when the patent is "sealed," which the statute, in the same section, describes in terms as the day on which it is "actually granted," and no

use of the invention before that day, so the statute enacts, can be complained of as an infringement. Under this very section, therefore, and to give effect to it, the courts, in suits *inter partes* and enforcing rights under the patent, must ascertain the day of sealing, and treat that as the day on which the patent is "actually granted." A similar duty is imposed on the courts under § 20, which provides that the patent shall be void "unless the same be *actually* granted during the continuance of the provisional protection under this act," and a similar duty is imposed under Act 18 Hen. VI., c. 1, referred to in the very section (23) which permits a certain authority. The "provisional protection" is clearly, therefore, not the "grant of a patent," and the *date* of the patent is neither conclusive nor *prima facie* evidence, therefore, of the time of the grant. (See the text, pp. 17–19, *infra*.)

This provision, the first step in which (the preliminary certificate and advertisement) is what is called "provisional protection," gives the applicant no right to a patent and no rights whatever against the public, but simply so far relieves the crown from the absolute prohibition of 21 Jac. I. But it leaves the crown free to do as it pleases, when the time comes for affixing the great seal, and the patent is sometimes antedated and sometimes not. This is determined at the time of sealing, after public notice and hearing opposition, if any.

Stat. 21 Jac. I. (p. 8, *infra*) provides also that the patent shall not run for *more* than fourteen years "from the date" of the Letters Patent; it may run for less, if the crown sees fit. This "date" is not determined until the final hearings before the Attorney-General, and before the Lord Chancellor.

The provisional specification and provisional protection together somewhat correspond to — substantially are of no greater effect than — a caveat, and our statute allowing two years' public use before patent. They do not require the careful description needed in a patent. They do not insure a patent; they require further steps, — the real request for a patent ("notice of intention to proceed"), the payment of more and larger fees, inquiries whether a patent ought to issue, and the judicial determination thereof, possibly involving a severe public contest, and a determination when the

patent shall be dated, when it shall begin, and when it shall expire. The preliminary proceedings — the "provisional specification" and "provisional protection" — in England do not insure a patent, nor even start the inquiry on the merits whether one shall be granted. They merely prevent certain public use from destroying it, if it shall thereafter be granted.

The first steps calling for the hearings at which was to be determined whether a patent should issue, and if so, what inventions it should include, what should be its date, and when it should expire, and the advertisements of them, and the payments (£10), did not take place until more than a month after the United States patent had issued.

The facts, therefore, are that, on Jan. 30, 1877, when Mr. Bell received his United States patent 186,787, Morgan-Brown, the English applicant, was not clothed either with the monopoly which it is the object of the patent law to grant, and which makes the invention "patented," nor did the document which alone authenticates those rights, the Letters "Patent," exist. Whether such rights and such paper ever would exist, and if so, what their scope would be, on what day they would begin, and on what day they would expire, what inventions would be "patented," or, in the language of this answer, be "described and claimed" in the grant not then decided upon, remained to be judicially determined. The only thing certain on Jan. 30, 1877, was that *then* no such rights existed, and that under the law they could not, in respect of that day, even retrospectively be created. Every man in England could use the invention on that day, and could never be called to account for such use. And how could any man, on Jan. 30, 1877, state in the United States patent what the future would bring forth in England touching the matters referred to?

If the crown thereafter, issuing a patent, should choose to antedate it, that would only be a form of procedure and a legal fiction adopted to relieve the crown in part from the restrictive prohibition of the old statute; and whether the crown would please to avail of it or not, had not been determined when the United States patent issued. It can, therefore, have no effect on the rights conferred by the United States patent.

We have certified copies of the English patent files, and will now state in detail those proceedings, the language of the statutes under which they were taken, and of the courts and the highest authority in the Patent Office (the Lord Chancellor administering the great seal), construing those statutes.

Details of the English proceedings and statutes.

Certain differences of theory between the grant of patents in the United States and the grant of patents in England color the whole course of procedure in the latter country, and give meaning to its various steps.

In England no statute gives a right to a patent. In theory of law, the grant is of the royal prerogative and of the mere royal pleasure (*v.* p. 9, *infra*). All that the statutes have done, in form or in terms, is to *limit* the royal power, and declare the forms which shall be followed in respect of its exercise. The controlling statute (incorporated into the later statutes by reference) is the Statute of Monopolies (21 Jac., I. c. 3), which, abolishing all monopolies, saves patents hereafter to be issued and not to exceed a certain term, if they come within certain defined exceptions.

Stat. 21 Jac. I., c. 3, sect. 6, is: "Provided also, and be it declared and enacted that any declaration before mentioned shall not extend to any Letters Patents and grants of privilege for *the term of fourteen years or under*, hereafter to be made, of the sole working or making of any manner of *new manufactures within this realm*, to the *true and first inventor* or inventors of such manufactures, which others, *at the time of making such Letters Patents* and grants, shall not use; . . . the said fourteen years to be accompted *from the date* of the first Letters Patents or grant of such privilege hereafter to be made, but that *the same shall be of such force as they should be if this act had never been made*, and of none other."

The subsequent acts, particularly that of 1852, under which patent 4,765 was issued, somewhat modify these *limitations on the exercise of the royal prerogative*, but give no other authority for the grant of patents for inventions, which still owe their force to the great seal affixed by the Lord Chancellor as the keeper thereof. Thus Act 1852, § 55, says: —

"The expression 'invention' shall mean any manner of new manufacture the subject of Letters Patent and grant of privilege within

the meaning of the Act of the twenty-first year of the reign of King James the First, chapter three."

St. 21 Jac. I. provides that the unforbidden grants "shall be of such force as they should be if this Act had never been made, and of none other."

The form of the clauses of Act 1852, which especially touch the granting power, is, "it shall be lawful" (*e. g.*, §§ 14, 15, 16, 18, 23); while § 16 in terms provides that her Majesty may of her own prerogative refuse to grant Letters Patent in any particular case, or may insert therein restrictions, conditions or provisos other than those named in the Act.

Sect. 16. "Provided, also, that nothing herein contained shall extend to abridge or affect the prerogative of the crown in relation to the granting or withholding the grant of any Letters Patent; and it shall be lawful for her Majesty, by warrant under her royal sign manual, to direct such law officer to withhold such warrant as aforesaid, or that any Letters Patent for the issuing whereof he may have issued a warrant as aforesaid, shall not issue, or to direct the insertion in any Letters Patent to be issued in manner herein provided, of any restrictions, conditions, or provisos which her Majesty may think fit, in addition to or in substitution for any restrictions, conditions or provisos which would otherwise be inserted therein under this act; and it shall be lawful for her Majesty, by like warrant, to direct any complete specification which may have been filed under the provisions hereinbefore contained, and in respect of the invention described, in which no Letters Patent may have been granted, to be cancelled, and thereupon the protection obtained by the filing of such complete specification shall cease."

Strong words. Doubtless Parliament hoped that the royal will would generally be pleased to follow the accustomed course of procedure; but it is to be a will not *bound* by fixed rules; not administering a statute as a court does. As matter of law, its action cannot be predicted; it can only be known from the thing *actually done*.

Feather v. *The Queen*, 6 B. & S. 257; Goodeve, 191 (1865). Per COCKBURN, C. J. "The statute of James was only declaratory of the common law, and then grants of monopoly in respect of inventions are not by force of the statute, but by virtue of the prerogative." . . . "The grant of the patent is simply an exercise of the prerogative."

See also pp. 23–6, *infra*.

The invention is not patented until the crown determines to exercise its prerogative, and to grant the monopoly. When was that in this case?

The old statute (21 Jac. I.), still in force, forbade the crown to give a patent if the invention was known to the public at the instant of "making" the grant. This was held by the English courts to mean that no valid patent could issue for an invention which had been previously used in public, or described in a printed publication accessible to the public, even though the use or publication were derived from the applicant and true inventor. *Wood* v. *Zimmer*, 1 Webs. 44, n.; *Huddart* v. *Grimshaw*, 1 Webs. 85, 86; *Losh* v. *Hague*, 1 Webs. 200, 205; *Elliott* v. *Aston*, 1 Webs. 222–4; *Cornish* v. *Keene*, 1 Webs. 501, 509, 519; *Carpenter* v. *Smith*, 1 Webs. 530, 534, 540, 543; *Household Co.* v. *Neilson*, 1 Webs. 673, 708, 710.

The new statute modified this, by providing that under certain circumstances the crown *might* antedate the patent, but only with a certain limited effect, to wit, that as regards the effect of public knowledge, the date so given should be taken as the date of "making." The patent later in date, if two describe the same thing, is void from the mere existence of the former, because "Letters Patent" are a publication, though the later patentee be, and the earlier be not, the true and first inventor. The date, therefore, has for English purposes a meaning and importance quite other than any given to it under the United States law, and there is thus a reason for antedating in England which our law does not afford.

The proceedings in detail.

The English Patent Office is required by law to keep a "register" or docket of all proceedings in the matter of the grant of each patent. We have a certified and authenticated copy of the "register" for patent 4,765, and certified and authenticated copies of the papers filed and orders made. With these and with the statute, it is easy to determine when the invention in question was "patented."

The copy of the register is marked "*Exhibit L.*"

The proceedings were under the Act of 1852, and were all taken by, and the patent issued to, William Morgan-Brown, who described

the invention as "a communication to him from abroad by Alexander Graham Bell."

"9th *Dec.*, 1876." First papers filed consisting of
(1) Petition (Exhibit A).
(2) Declaration (Exhibit B).
(3) Provisional specification (Exhibit).
(Stamp duty £5. See § 6.)

These papers, *on filing*, received a number (4,765), which all subsequent papers, including the patent, bear.

Dec. 13, 1876, an order is written on the petition, as follows:—

"13th Dec., 1876. Her Majesty is pleased to refer this Petition to Her Majesty's Attorney-General, to consider what may be properly done therein."

By sects. 7, 8, it is the duty of the law officer *at this stage* to ascertain whether the papers are proper in form to constitute a *good application;* not whether a patent ought to be granted. The language of the statute is:—

"And if such law officer be satisfied that the provisional specification describes the nature of the invention,* he shall allow the same, and give a certificate of his allowance."

He can also allow amendments to meet objections which he raises.

The next entry on the register is:—

"27th December. Certificate of Attorney-General allowing provisional protection with new declaration added, received, filed, and certificate thereof given."

The new declaration is C. The order of the Attorney General is as follows (*c. c.*):—

"Whereas, the declaration and the petition are insufficient, I hereby allow the same to be amended by adding to the documents the new declaration marked "A," annexed hereto, and correcting the petition in accordance therewith, to which amendments I have placed my initials.

"JOHN HOLKER.

"23d December, 1876."

Thereupon, the Commissioners issue a "Certificate of Provisional Protection" (D), and the next entry is under § 11:—

* For the meaning of this phrase, see the decisions, pp. 27-8, *infra.*

"5th January, 1877. Provisional protection advertised in *Gazette*."

"Provisional Protection," — what it means.

The phrase "provisional protection" does not mean that the invention is even provisionally or incipiently clothed with the monopoly which it is the object of the patent law to give, and which is signified by the word "patented." It has a special and peculiar significance. The provision which has already been explained (p. 5, *supra*) rests for its ultimate and indeed sole effect upon two steps, which provide that the pendency of the application shall be advertised, and that, in respect of applicants who have so advertised, the restriction of 21 Jac. I. is lifted *from the sovereign* as to inventions unpublished at the time of the application, and then, leaving the will of the sovereign entirely untrammelled, point out by what form of procedure the royal conscience shall be enlightened and the royal will manifested.

The first step is chiefly regulated by § 8, part of which has been quoted, and which provides that, after the certificate of the Attorney-General: —

"Thereupon the invention therein referred to may, during the term of six months from the date of the application for Letters Patent for the said invention, be used and published without prejudice to any Letters Patent *to be* granted for the same, and *such protection from the consequences of use and publication* is hereinafter referred to as *provisional protection*."

That is, without prejudice to Letters Patent, if any shall be granted, — "to be granted," — in the future.

The statute thus again expressly recognizes the fact that after the "provisional protection" has been obtained and advertised, and before any other steps have been taken, the patent still is "to be" granted. It does not then exist, either in fact, or in contemplation of law.

In other words, the certificate of provisional protection and the proceedings up to that time give to the applicant a status less strong than that acquired in the United States by the mere filing of an application. In the fulness required, and the incompleteness permitted in the specification, as well as in the legal effect of the pro-

ceedings, they substantially agree with what is required of and gained from a caveat and from the statutes allowing two years' use before application. It neither gives nor insures a patent; but it puts the party in a better position to obtain one as against intermediate invention or use by others, and may save the validity of a patent, if one shall be afterwards asked for and granted (v. p. 6, *supra*). In short, in the words of the statute itself, it is a permission to him to "use and publish" it meantime without necessarily debarring himself from receiving a patent. For the relations between a *provisional* and a *complete* specification, see pp. 27–9, *infra*.

The force and effect of this clause is better understood when read with the other provision connected with it, which will be referred to presently (p. 16, *infra*). It has been construed in the cases referred to on pp. 23–5, *infra*.

If proceedings stop here, no patent ever issues. The applicant must take further steps, pay further heavy fees, and two judicial determinations must take place to determine whether a patent shall issue.

It was at this stage and before any further steps were taken, that the United States patent was actually granted and issued, Jan. 30, 1877.

The next steps are described on the register as follows: —

"8th February. Notice to proceed received and filed, and certificate thereof given." [E. F.]

"13th February. Notice to proceed advertized in *Gazette*."

"8th March. Petition, declaration and provisional specification again referred to Attorney-General."

Upon this a stamp duty of £5 is to be paid.

The statute provisions upon these steps are as follows: —

SECT. 12. After notice of intent to proceed and advertisement thereof, "any persons having an interest in opposing the grant of Letters Patent for the said invention shall be at liberty to leave particulars in writing of their objections to the said application," etc.

SECT. 13. The papers and the objections, if any, are to be referred to the law officer (Attorney-General).

This reference is endorsed upon the original petition (A), as follows: —

"8th March, 1877. Her Majesty is pleased again to refer this Petition to Her Majesty's Attorney-General to consider what may be properly done therein."

Upon this, and after a hearing upon affidavits or other proofs, if any objector appears, and respecting which he can allow costs and have them made a rule of Court, the law officer in the first instance determines *whether any patent shall issue.*

SECT. 15. "It shall be lawful for such law officer, after such hearing, if any, as he may think fit, to cause a warrant to be made for the sealing of Letters Patent," etc., in a prescribed form.

The entries in the register are :—

"12th March. Fiat for warrant received."

The fiat endorsed on the petition (A) is as follows : —

"Let a warrant be prepared for my signature upon the within Petition limited to the United Kingdom of Great Britain and Ireland, the Channel Islands, and the Isle of Man.

"JOHN HOLKER,
"8th March, 1877."

The next entries are : —

"8th May. Warrant left with Attorney-General for signature."
"10th May. Warrant received, sealed and filed."

The warrant (I), dated May 8, 1877, addressed to the Lord High Chancellor, recites briefly the proceedings, and the essential words are : —

"I am of opinion that her Majesty may grant her Royal Letters Patent," etc.,

and it then sets forth in full the form of the Letters Patent (not the specification), for the statute (§ 15) expressly provides that the law officer shall in his warrant direct the insertion in the patent of such claims as he may deem "usual and expedient in such grants."

SECT. 18. "The commissioners, so soon after the sealing of the said warrant as required by the applicant," who is to pay a third £5 on the warrant, "shall cause to be prepared, Letters Patent for the invention," "and it shall *be lawful* for the Lord Chancellor to cause such Letters Patent to be sealed with the great seal of the United Kingdom," for which sealing the applicant pays another £5.

The warrant in this case is dated May 8, 1877, and bears the endorsement : —

"Received the fifteenth day of May, 1877. Cairns C."

The seal was actually affixed on that day, and the register contains the entry: —

"15th May. Letters Patent prepared, sealed, and dated the 9th of December, 1876."

But the sealing by the Lord Chancellor does not necessarily follow from the warrant, for, as representing the royal prerogative, he may still refuse to seal the patent, or may insert therein divers provisions, and may determine the date of the patent. This power is expressly saved by §§ 15, 16 (quoted p. 9, *supra*), and may be and not unfrequently is invoked by opponents who are thereupon heard upon proofs. Some reported cases of such hearings will be referred to.

The *patent*, in the sense in which we understand the word in America, viz., the papers upon which the inventor can bring an action, is not yet complete. The Letters Patent describe the invention only by its title, — in this case "Improvements in Electric Telephony (transmitting or causing sounds for telegraphing messages)," — but contain a provision that they shall become void unless, within a time limited, the patentee shall, in a paper to be filed, "particularly describe and ascertain the nature of the said invention, and in what manner the same is to be performed." This is to be made public, while the provisional specification is kept secret until some time after the sealing of the Letters Patent. Upon filing this "complete" or final specification, the patentee pays another £5.

The provisional specification does not show what invention will be patented.

That only is patented which is claimed. This is the rule in England (see cases cited, pp. 27–8, *infra*), as well as with us. The provisional specification is not required to have claims, and in this case had none. The only claims ever filed by Morgan-Brown in 4,765 were contained in the final specification filed June 9, 1877, and in the amended and disclaiming specification (a considerable part of what Mr. Bell had done in America having been published in England before Dec. 9, 1876), filed Feb. 13, 1878. How could this Court, sitting as of Jan. 30, 1877, say from the provisional specification, if it had a right to refer to it, what invention ever would be patented?

No paper which then existed bore out the allegation, properly made in the answer, that any particular invention covered by any particular claim of the second United States patent was "described and claimed," or would be "described and claimed" in any patent even, thereafter, to be issued in England.

Indeed, that provisional specification described as new and as Mr. Bell's invention many inventions made by him besides those covered by his United States patent of Jan. 30, 1877. It incorporated in its "six plans" the substance of five United States patents, including his great speaking telephone patent of March 7, 1876. It turned out in the course of the proceedings that Mr. Bell's fame reached England so quickly that much of this was published there before Dec. 9, 1876, and consequently could not be patented. If the Commissioner or this Court could, on Jan. 30, 1877, have inspected all the secret files of the English Patent Office, neither could have ascertained what inventions Morgan-Brown even asked to have "patented"; for he had not specified — in the language of the English statute (*v.* p. 28, *infra*), "particularly described and ascertained"— the invention which, in the language of JESSEL, M. R. (p. 27, *infra*), was or was to be "*comprised in the patent*"; and the time for him to do so had not arrived

The antedating, — its purpose and meaning.

One more matter is to be determined in the course of the final proceedings already mentioned.

The provisional protection annuls the restriction of the statute of monopolies so far as to *permit* the sovereign to grant the patent, although the invention be not new "at the time of making such Letters Patent," if it was new at the date of application. But this leaves the sovereign free to act its pleasure in that regard. The next provision recognizes that the crown may act its pleasure in that regard, and directs how its will and determination shall be manifested.

It is manifested by dating the patent on the day when it is actually sealed, or by antedating it as of any day not earlier than the filing of the application, as the crown may see fit. It will be "of the same force and *validity* as if it had been sealed on the day as of

which it is expressed to be sealed and bear date," but "no proceedings in law or in equity shall be had upon such Letters Patent in respect of any infringement committed before the same *were actually granted*." See §§ 23, 24, quoted, pp. 17, 18, *infra*. In other words, the antedating, *if the crown* does it, only saves the *validity* and determines the duration of the patent. It does not clothe the patent with the monopoly, either actually or retrospectively, for a single instant before the moment when the patent is actually sealed; in the words of the act, before it is "*actually granted*."

The date is of an importance in England which it does not have in this country. For if the thing be known before the "making" of the patent, which by statute is, *for this purpose only*, taken to be the date thereof, the patent is void, though it be granted to the original and first inventor (p. 10, *supra*). The date, therefore, in cases of opposition from a rival applicant, becomes a matter vital to the parties. It may be remarked also, that no English statute fixes the **duration** of a patent. The only provision is in the statute of monopolies, which, in the passage quoted (p. 8, *supra*), enacts that it shall not exceed fourteen years "from the date of the first Letters Patent." It is the date of the patent only which limits the term, and in practice fixes it, the form prescribed by the statute of 1852 being to grant for "fourteen years from the day of the date of these presents."

The statute (1852, 15 & 16 Vict., c. 83) is:—

"SECT. 23. *It shall be lawful* (Act 18 Hen. VI., c. 1, or any other act to the contrary notwithstanding) to cause any Letters Patent to be issued in pursuance of this act, to be sealed and bear date as of the day of the application for the same, and, in case of such Letters Patent for any invention provisionally registered under the 'Protection of Inventions Act, 1851,' as of the day of such provisional registration, or where the law officer, to whom the application was referred, or the Lord Chancellor thinks fit and directs, *any such Letters Patent as aforesaid may be sealed and bear date as of the day of the sealing of such Letters Patent, or of any other day between the day of such application or provisional registration and the day of such sealing.*

"SECT. 24. Any Letters Patent issued under this act, sealed and bearing date as of any day prior to the day of the actual sealing thereof, shall be of the same force and validity as if they had been sealed on the day as of which the same are expressed to be sealed

and bear date; provided always that (save where such Letters Patent are granted for any invention in respect whereof a complete specification has been deposited upon the application for the same under this Act) no proceeding at law or in equity shall be had upon such Letters Patent in respect of any infringement committed *before the same were* **actually granted."**

Indeed, the statement on the face of the warrant for the patent, and on the face of the patent itself, following the form given in the statute, is not "sealed on Dec. 9, 1876," but "sealed *as of* the said Dec. 9, 1876."

The Act 18 Hen. VI. recites the great wrongs that have been done by antedating patents for "offices, terms, and other things," whereby they took effect as of a time long past, against the rights of those in lawful enjoyment, and made that unlawful which, when done, was according to law. It introduces a new feature into English law. The old rule was that a royal grant was conclusively presumed to be made at the date affixed. This statute provided that when a warrant came to the Chancellor to affix the great seal, there should be made a record of the date of "the day of the delivery of the same to him," and that the Letters Patent to be sealed by him should bear date of that day,

"And not before in anywise; and if any Letters Patent be from henceforth made to the contrary, they shall be void, frustrate, and holden for none."

From that time forward, therefore, the courts were not bound by the date of a patent. They looked behind that, and, if they could look at no other proof, they certainly could and must look at the day of the receipt of the warrant, as recorded under the statute, and by that ascertain the time of making.

Such a record exists here. The Patent Office is by statute the Chancellor's record office for matters relating to patents, and the "registry" shows that the warrant was received May 10, 1877, in the Patent Office, while the record made by the Lord Chancellor himself, and signed with his own hand on the warrant, is:—

"Received the fifteenth day of May, 1877. Cairns, C."

Earlier than that the patent cannot be dated or exist, except so far as Act 1852 permits, and only for such effect and purposes as it specifies.

(These matters can be found in Hindmarch on Patents, which relates to the old law before 1852.)

Statute 1852 permits the antedating *only to save the life* of the English patent. It is not to retroact on rights acquired by any one meantime; it is not to cause the wrong which the *present law of England* (18 Hen. VI., c. 1) forbids, describing in its quaint language the evils of antedating "grants of offices, terms and other things,"

"by reason whereof, divers of the king's liege people, having such offices, terms, and other things of the gift or grant of the king, by his gracious Letters Patent thereof to them long time before duly made, by such subtle imaginations of such antedates, desired by such petitions of such offices, terms and other things, often have been put out, removed and expelled against right, good conscience and reason."

Yet these defendants wish a patent, made by the Queen of England, on May, 15, 1877, to expel Mr. Bell from the term long before granted to him by American Letters Patent, and to do this by the "subtle imagination of antedating," and upon the argument, as much "against reason" as "against good conscience," that the United States Commissioner should have, on Jan. 30, 1877, stated a fact which did not exist, and a date which had not been determined.

We have seen that whether the patent is to be granted or not, is to be determined by judicial inquiries, and that these inquiries are open until it is actually sealed (*v.* cases quoted, pp. 23, 6, *infra*). The first inquiry by the law officer in this case, made after notice to all the world to oppose, did not, by law, take place until after the "notice to proceed," which was filed Feb. 8, 1877 (the United States patent being Jan. 30, 1877). In fact, it was March 8-10 when the papers were referred to the Attorney-General. The same inquiry is again open before the Chancellor, up to the moment when the seal is affixed.

In the same way, upon each of these hearings, each officer *determines what date the patent shall bear;* and not unfrequently it is ordered, sometimes by the Attorney-General, and sometimes by the Lord Chancellor, that the patent be dated on the day of actual sealing. See § 23, and the reported cases before the Lord Chancellor (pp. 24, 6, *infra*).

The condition of things in England when the United States Patent issued.

On Jan. 30, 1877, the date of Mr. Bell's United States patent, 186,787, no invention of his had been patented in England. The invention was free to be used by every one in England. The English patent, 4,765, did not then exist. No grant could thereafter be made which would even retrospectively make the monopoly exist as of that day.

It was not known whether the invention ever would be patented; if it should be patented, it was not then known when the monopoly would begin, when the patent would be dated, nor when it would expire; for by the English law it must expire in England not later than fourteen years from the date of the patent, — a date afterwards to be determined. The applicant had not even indicated by claims or otherwise what invention he wished to have patented.

These matters were to be determined by judicial inquiries after notice to all the world to oppose. The inquiries were to be made first by the Attorney-General, and afterwards by the Lord Chancellor in person. They must first be called for by a "notice to proceed," and the advertisement thereof, and the payment of heavy fees. The first of these steps had not been taken when the United States patent issued.

The only thing certain was that no power existed to make the invention "patented"; that is, to clothe it with a monopoly or privilege, as of that day even retrospectively. There was not even a proximate legal certainty that the invention would be patented.

It was not in the condition of a case, the merits of which had been passed on, though some details remained to be settled before the entry of a formal decree.

It ranked at most like a legal proceeding in which the Court had, *ex parte*, looked at the face of the petition enough to say that it would issue an order to show cause if the party should thereafter move for one.

Indeed, the only probability in fact (if such a consideration could weigh), that the applicant would pay the fees, invoke the inquiries, and that they would all result in his favor, rested upon a belief:—

1. That Mr. Bell was the first inventor of the telephone, and having made so startling an invention would be likely to patent it in England, or to sell the right to do so: because, though in England the word "inventor" is construed to mean one who brings into the realm what he has learned abroad (Edgeberry *v.* Stephens, 1 Webs. 35; Beard *v.* Egerton, 3 C. B. 128; Goodeve, 39), the usual practice, recognized by the rules, is for the importer to state the invention as a "communication" from the true originator.

2. That no one, even having learned the invention from him, had published it in England.

In other words, upon a belief that substantially all the allegations of the defendants' answer are false; upon a belief that the Lord Chancellor of England would find to be untrue (as we quite agree that he would and that this Court will) that which the defendants ask this Court to believe is true and was then well known.

What the defendants contend for.

The contention of the defendants here is that the United States statute should read that the life of the American patent be shortened if a foreign government should thereafter, by act *ex post facto*, grant a patent for the same invention, and should thereafter, by act *ex post facto*, see fit to antedate its own patent. Such is not the statute; if it had been so drawn in terms, it would not be law.

Their contention goes beyond that and to the point of absurdity. The English patent still exists, and will until Dec. 9, 1890. At what period after that this patent will expire is, for this case, a mere moot question. Their contention is (and to make a defence must be), that the United States Commissioner of Patents should, on Jan. 30, 1877, have stated the day on which an ungranted and non-existent English patent would expire; and should state which particular invention among many *described* in a paper he could not see, Morgan-Brown would *thereafter* ask to have patented, and the English sovereign would clothe with the monopoly.

Lord Romilly once said that the most dangerous thing for a Court to attempt was, leaving what was *done*, to dive into the heart of a man and discover his secret intentions in the past. But here the Commissioner must project himself into the future, and discover, and

correctly and conclusively certify what would be the judgment of a future Lord Chancellor upon a matter which might be contested by proofs and arguments, — upon a controversy, in short, which had not arisen.

Some English decisions under the English statutes.

These give a construction to the statutes and *show that the date of the patent as well as the question of granting one are matters judicially determined and certain, only at the time of* **sealing or "actually granting,"** *and not before.*

Saxby v. *Hennett*, L. R., 8 Ex. 210; Goodeve, 416 (1873). Saxby applied July 20; E., Hennett's grantor, applied July 25; patents were sealed to both, and dated as of the respective days of application. E.'s was sealed first, but bore the later date. In a suit, S. *v.* E.'s grantee, *held* that as respects "validity," each patent must, by force of the statute, be deemed to have been "made" as of its date, and therefore that E.'s, dated later than Saxby's, was not a publication which destroyed it, and Saxby should prevail. No other defence.

But where a corresponding conflict arises *in the Patent Office* or before the *Chancellor*, as upon a request by the earlier applicant to have a patent sealed to him, after one has already been sealed to the later applicant, so that the question was not what effect should be given to inconsistent grants already made by the crown, but whether the crown should make the second grant, the usual rule is to refuse the grant to the second person moving for the seal, although he was the first to file his application for a patent, or else to date his patent as of the day of actual sealing, which will give him a bad patent for so much as is common to both. For the "provisional protection" is of no advantage unless the crown avails itself of it by antedating the patent, and *it does not even bind the crown to disregard intermediate publications or patents, nor to antedate in accordance with it. It enlarges the power and discretion of the crown, but gives no right whatever to the party.*

This has been decided as follows: —

Ex parte Bates, L. R., 4 Ch. 577; Goodeve, 594 (1869). Bates filed his application Oct. 2, 1868, and obtained provisional protection. Bertie applied Nov. 2, 1868, and on Dec. 12, 1868, his patent was sealed; now, on March 19, 1869, Bates moved to have a patent

sealed to him, and insisted that nothing done by a third person or by the crown after he had obtained "provisional protection" could have any effect against him; *Held* that Bates's patent must be dated as of the date when actually sealed, and could then be only for what was in his specification and not in that of Bertie. No question of originality or date of *invention* was raised.

LORD HATHERLY, L. C. "A person who intends to take out a patent may under 15 and 16 Vict., c. 83, § 6, leave a '*provisional*' specification at the office of the Commissioners, and then he will have certain benefits. Under § 8, for instance, he may use his invention for six months without prejudice to his patent by that user, but *he obtains no rights against the public until his patent has been sealed*, and even then the patent *will not relate back to acts done in the interval*. But that is all and he has no right or privilege against any other person. If he wishes to have more, he may, under § 9, file a '*complete*' specification, and then he is absolutely protected for six months, and has a right to proceed as if he had a patent for that period. The publication of the complete specification gives to the world the whole benefit of the invention, and then the inventor will be protected against any other person obtaining a patent for the same invention. . . .

"I ought not to antedate the patent, and, if granted, it must be as of its proper date; but when one patent actually exists, and is brought to the notice of the Lord Chancellor, a second patent will not be granted for the same invention," but may be for what is not in the first patent.

Ex parte Yates, L. R., 5 Ch. 1, and *Exp. Manceaux*, L. R., 5 Ch. 518, L. R. 6 Ch. 272; Goodeve, 596–7 (1869–1870). LORD HATHERLY, L. C. refused patents upon objections first taken and opposition first made before him on the application for the great seal.

In re Henry's patent, L. R., 8 Ch. 167; Goodeve, 598 (1872). The Attorney-General issued warrants for the sealing of patents to each of two contesting parties. The Lord Chancellor (SELBORNE) sealed one, and refused to seal the other.

Ex parte Scott, L. R., 6 Ch. 274; Goodeve, 597 (1871). Scott applied for a patent. Then Pocock applied for a patent, and got it sealed. Then Scott moved for the great seal, and Pocock opposed. The dates therefore were exactly like those in Bates's case. But the same Lord Chancellor (Hatherly) found that Pocock, who was Scott's employer, had actually stolen the invention from Scott, and therefore he sealed Scot's patent and antedated it to the day of his application for the patent. This killed Pocock's.

Ex parte Bailey, L. R., 8 Ch. 60; Goodeve, 600 (1872). Bailey filed his application, and obtained provisional protection March 30. Cassartelli filed his April 3, and got a patent. Afterwards Bailey, on May 21, moved for the great seal. LORD SELBORNE, L. C., sealed the patent, but dated it May 21.

In re Harrison, L. R., 9 Ch. 631, Goodeve, 601 (1874). The dates were as in Bailey's case, and LORD CAIRNS, L. C., said: —

> "If I find a similarity [between the specifications], then I shall take the course which has been taken in other cases, and allow the patent to be sealed, but dated as of the date of the *application for the great seal.*"

In re Deering, L. R., 13 Ch. 393; Goodeve (1879). Before EARL CAIRNS, L. C. R & D, independent, original and separate inventors, each filed applications on the same day, for the same invention. R got his patent sealed and dated as of the day of the application. Now D applied for the seal and R opposed. The Lord Chancellor sealed a patent to D, and dated it of the day of D's application, thus giving the same date to both patents, and leaving them to fight out the question of priority of *invention* in the courts.

Re Cutler's patent, 1 Webster, P. C. 420. The Lord Chancellor has full jurisdiction at the last moment to affix or to refuse to affix the great seal, all his power in this respect being expressly reserved by §15 of the act of 1852.

In re Admamson's Patent, DeG. M. & G. 420; Goodeve, 589 (1856). LORD CRANWORTH, L. C., refused the great seal on the ground of public use by the applicant before his application.

In re Henry's patent, L. R., 8 Ch. 167 (1872). Before Lord Chancellor SELBORNE. This case both decides and illustrates the legal and practical uncertainty which prevails in England upon an application, until the great seal has been actually affixed. It is the more important because the defeated party had not deposited a "provisional" specification under § 8, as Morgan-Brown did about Mr. Bell's invention; but with his original petition had deposited a "complete" and final specification under § 9, which deposit would seem, according to the language of the statute and the intimation of Lord Hatherly in *Bates's* case (p. 23, *supra*), to give him a higher standing than the filing of a provisional specification, and the grant of "provisional protection" would give. But the Chancellor held that it was always a question for time to decide, and at the last moment, whether he would affix the great seal or not, and here he refused it, and granted it to another applicant.

Farquharson applied and filed a *provisional* specification, and obtained provisional protection under § 8, May 25, 1872. Henry filed a *complete* specification and obtained "protection" under § 9, on Aug.

26, 1872. Afterwards, both applied for the great seal, each alleging that the other stole the invention from him. The Attorney-General after hearing issued a warrant for a patent to each. The Lord Chancellor found that Farquharson was the true and first inventor, granted the patent to him and refused it to Henry.

THE LORD CHANCELLOR. "Mr. Henry applied for a patent Aug. 26, 1872, and at the same time filed a 'complete' specification; and the question was whether the effect of that complete specification under the statute was to make an answer to any claim by any one else who had previously applied for a patent for the same thing, alleging himself to be a prior inventor. The argument was founded upon the case of Bates & Redgate, which decided that where a patent has actually been sealed, the crown will not afterwards enter into the question whether or not some one else, who had previously applied, was a prior inventor, so as to give a subsequent grant for the same thing which had been granted before. The principle of that decision rests plainly upon this, that what the crown has actually granted cannot be taken away from the grantee, if it is vested in him, and given to somebody else; and that the grant is not to be assumed to be void in this jurisdiction, but must be repealed by *scire facias*, before the crown, consistently with the principles applicable to all crown grants, could properly grant the same matter over again. Then it was attempted to transfer the principle of that decision to a case like the present, because there is a clause in one of the acts of Parliament which says that for a period of six months, every person who has applied for a patent, lodging a complete specification, shall have the same rights, powers and privileges (I think those are the words) as if the patent had been sealed on the date of his application. Now it is quite manifest that the whole of that proceeds upon the footing that a patent had not actually been sealed, and that every opposition of this kind addresses itself to the question whether a patent ought to be sealed or not. That proviso of the act of Parliament gives to the act, not of the crown, but of the party, such an effort as would put him for a limited period of time in the situation which, on the face of the royal grant, he would appear by the terms of that grant, according to its legal import, to be put into. Such a question cannot possibly be material to the sealing. The whole foundation of that clause of the act of Parliament is that there has been no sealed patent. The whole question now is whether there should be a sealed patent, and to whom. The interim advantages given to a man who has lodged a complete specification are not the same in all respects, but the like, and the words 'rights, powers and privileges' do not refer to anything which

is not the effect of the document in itself. Supposing the conditions are not fulfilled, the document would pass, in point of law, no rights, powers or privileges, unless it had been sealed, and cannot possibly be an obstacle to the exercise of this jurisdiction for the purpose of determining who is entitled and who is not entitled to have the patent sealed. It is not contended that the mere lodging a complete patent entitles the party who lodges it to have his patent sealed at all events, or sealed if he applies for it within six months; no one can contend that. But as the argument is not good for that, it is not good for anything at all. The analogy is false, because the doubts proceeded upon principles applicable to where a grant has been actually made and sealed; but in a case where *no such grant has been made* or sealed, there is no obstacle to the crown doing what may appear to be right and just."

The Lord Chancellor then considered the question of fact at great length, and concluded: —

"I therefore decide that Mr. Farquharson's patent shall be sealed; that Mr. Henry's shall be refused, and that Mr. Henry pay the costs of this application."

That is, no grant whatever has been made or determined upon un til the Lord Chancellor actually affixes the seal, and up to that moment any one may oppose the grant in pursuance of publicly advertised notice given to that end.

If the allegations in the answer of the defendants in this case, viz., that Mr. Bell's invention was described in sundry English patents and well-known printed books were true, any one could have presented those patents or publications to the law officer or to the Lord Chancellor at any time after the United States patent was granted (Jan. 30, 1877), and before May 15, 1877, and no patent therefor would ever have existed in England. Not only, therefore, did no patent exist, not only was there no legal proximate probability that it would exist, but the probability of its existence (if such an element could be considered here) depended upon the assumption that the Lord Chancellor would find to be unknown and non-existent those matters which the defendants wish ("expect" would be too strong a word) this Court to believe existed, were widely published and well known. The *possibility* of a patent depended upon the law officer and the Lord Chancellor reaching a conclusion which the defendants say no court can reach. Both their defences cannot be true; both may be, and are false and ill-founded.

Whether the invention patented by Mr. Bell's United States patent was or would be patented in England could not be known until the "complete specification" was filed on June 9, 1877.

So much, and only so much of the described matter as is claimed, is what is patented (Brown *v.* Guild, 23 Wall., 181). For this reason, every reported case in the United States, from O'Reilly *v.* Morse to the present time, has held that we could not say that a particular invention had been "patented" in England until the "complete" specification had been filed. (See pp 15, 16, *supra; infra*).

The English decisions agree with this.

This is the more important here because the provisional specification 4,765 *had no claims whatever. None were filed until and as part of the complete specification filed June* 9, 1877, *and many of the matters invented by Mr. Bell have been long ago disclaimed because published in England before Dec.* 9, 1876, *by those who had learned them from him. Who, on Jan.* 30, 1877, *could say what would be patented, or even what Morgan-Brown wanted to patent?*

Harrison v. *Anderston* Co., L. R., 1 App. Ca. 574; Goodeve, 223.

LORD CHELMSFORD. "The office of a *claim* is to define and limit with precision what it is which is claimed to have been invented and *therefore* **patented.**"

Hinks v. *Safety Lighting* Co., L. R., 4 Ch. D, 607; Goodeve, 254 (1876).

JESSEL, M. R. "I am anxious, as I believe every judge is who knows anything of patent law, to support honest *bona fide* inventors, who have actually invented something novel and useful, and to prevent their patents from being overturned on mere technical objections, or on mere cavillings with the language of the specification, so as to deprive the inventor of the benefit of his invention. This is sometimes called a 'benevolent' mode of construction. Perhaps that is not the best term to use, but it may be described as construing a specification fairly, with a judicial anxiety to support a really useful invention, if it can be supported on a reasonable construction of the patent." . . .

"It is for the patentee to tell the world that of which he claims the monopoly; to tell them, 'You may do everything but this, but this you may not do; this is my invention.' With a view of getting this into a narrow compass, it has long been the practice of patent agents to insert in specifications the distinct claim of what they say is **comprised in the patent**, meaning that nothing else is comprised, that everything else is thrown open to

the public; or, to put it in other words, if a man has described in his specification a dozen new inventions of the most useful character, but has chosen to confine his claim to one, he has given to the public the other eleven."

Newall v. *Elliot*, 4 C. B. N. S., 269; Goodeve, 328. The Court said: —

"The statute itself (15 & 16 Vict., c. 83) indicates this distinction between the provisional and final specification, for it calls the latter the *complete* specification, implying that the former is or legally may be executory and incomplete. Moreover, it enacts (§ 6) that the provisional specification is to describe the *nature* of the invention and no more; but when the statute comes to speak of the *complete* specification, its language is altogether different; it enacts (§ 9), that the complete specification shall describe not only the nature of the invention, but also the manner in which it shall be performed, and not only describe, but *particularly ascertain it*."

The language of § 9 is that the "complete" specification shall "particularly describe and ascertain the nature of the said invention, and the manner in which the same is to be performed."

Penn v. *Bibby*, L. R., 1 Eq. 548; L. R., 2 Ch. 126; Goodeve, 369 (1866.)

Lord Chelmsford, L. C. "It seems clear that the office of the *provisional* specification is to describe the nature of the invention, not with minute particularity, but with sufficient precision and accuracy to inform the law officer what is to be *the subject matter* of the patent. It is not at all necessary that the provisional specification should describe the mode or modes in which the invention is to be worked or carried out. That is left to the *complete* specification.

"Nor is it necessary that the complete specification should extend to everything comprehended within the provisional specification."

Stonor v. *Todd*, L. R., Ch. D. 58; Goodeve, 446 (1876).

Jessel, M. R. "A provisional specification was never intended to be more than a mode of protecting an inventor until the time for filing the final specification. It was not intended to contain a complete description of the thing so as to enable any workman of ordinary skill to make it, but only to disclose the invention fairly, no doubt, but in its rough state, until the inventor could perfect its details.

"Again, the provisional specification, as such, is not and cannot be known to the public; it is never published unless with

the final specification, when they become parts of the same document, except in cases when the time has passed within which the final specification must be filed or treated as abandoned."

In short, the provisional specification in substance should and in legal effect does so nearly correspond to our *caveat*, that it has no greater effect, indeed less binding effect than a *caveat* coupled with our statute allowing two years' use before application (*v.* p. *supra*).

Recent English decision upon the main question at bar.

The English Act of 1852, has a clause not unlike the United States statute, and which in certain cases makes the English patent expire "upon expiration or other determination" of the foreign patent for the same invention. Under this, the English Court has recently had to determine whether the right in Belgium was "obtained" when the patent was actually ordered to issue, or as of the date of the application to which the patent was *by law* inflexibly antedated.

Its decision covers this case. It also gives a rather happy definition of what is meant by the somewhat popular terms "patent" or "patented," the latter being the word of our statute. The case is the following: —

Nordenfeldt v. *Gardner*. High Court of Justice, Queen's Bench, official journal of the English Patent Office, for March 25, 1884, p. 11. *Baron* HUDDLESTON.

By § 25 of the English Act of 1852, where upon an invention made in a foreign country, "*a patent or like privilege for the monopoly or exclusive use or exercise of such invention in any foreign country is there obtained* before the grant of such Letters Patent in the United Kingdom," the English patent shall expire "immediately upon the expiration *or other determination* of the term during which the foreign patent shall *continue in force*."

Inasmuch as § 24 had provided that English patents might be antedated, and should have, except for recovery in respect of infringements in the interim, "the same force and validity as if they had been sealed on the day" of the date it had been established by Holste *v.* Robertson (L. R., 4 Ch. 9), that for the purpose of determining the validity and force of the patent under § 25, the Court must

read it as if actually sealed, that is, granted, on the day of its date. "They must be held to have been granted on that day for all the purposes of the Act" (JAMES, L. J., in Holste *v.* Robertson, quoted p. 31, *infra*). Nordenfeldt's English patent was dated May 13, 1873. It only remained, therefore, to determine the date of his Belgian patent.

By the law of Belgium, every patent asked for is to be granted without examination, provided the object be one of industry or commerce, and not contrary to public morals or public policy. By the express provisions of the Belgian statute the legal date of the patent is the date of the application, and it runs a certain length of time from that day. But the procedure is for the Minister of the Interior "without delay" to make a decree, officially declaring (*constatant*) that the prescribed formalities have been fulfilled. This shall be delived to the applicant and shall constitute his *brevet*.

> "The word '*brevet*' is used very much like the word 'patent' in England, in a double sense, sometimes referring to the rights which the patentee gets, and sometimes to the document authenticating those rights,"

says the Court very pertinently, and then proceeds to inquire when he becomes clothed with the right, and when he obtains the document.

The Belgian application was filed May 12, 1873, and the decree of the minister made May 31. The Court held that the patent or privilege, though antedated by law to May 12, was not obtained until May 31, and consequently did not affect the English patent, dated May 13.

The Court said: "It would seem that the act of the Minister of the Interior is not altogether a judicial act, nor entirely ministerial; for it *must* be granted if the prescribed formalities have been gone through, and the object be one of industry or commerce, not against good morals or public order or decency, or contrary to public policy, or it may be when the object is an addition to a patent already open to the public, as suggested in Mr. Drugman's affidavit.

"The *brevet* was applied for on the 12th May, and the decree of the Minister of the Interior on the 31st May. It was determined [expired] on the 17th November. The legal date of the invention or of the *brevet* would under Article 18 be the 12th May, and from that date its duration whould run. But that legal date was given to

it only when the decree of the Minister of the Interior, under Article 19, was obtained. It might never be obtained. The formalities might not have been complied with, or the first annual payments made under Article 17, or it might have been abandoned. The *brevet*, whether it be the document itself or "the right or like privilege for a monopoly," is only obtained when the patentee having made his application, the Minister of the Interior grants it. It, no doubt, is, for all ordinary purposes considered to take effect from its date, although upon this point there seems to be some difference in the affidavits of the experts; but, nevertheless, in my judgment, it is not obtained until the 31st.

"The word 'obtained' is specifically repeated four times in the twenty-fifth section, and I cannot help thinking, was intentionally used for the purpose of designating the exact period when by the act of the applicant and the act of the executive, the legal right of the patentee was established. No doubt, the object of the statute was as Lord Hatherly states in *Daw* v. *Eley* (L. R. 3 Eq. 510), to prevent the English manufacturer being fettered while the foreigner remains free; but I think it is also obvious that the English patent should be protected, if, by due diligence in England, it preceded the application [?] for the foreign patent. If it were intended otherwise, as Mr. Aston put it, nothing would have been easier than for the Legislature to have said, 'If a foreign patent is obtained which is dated before the English patent, then certain consequences shall follow.'"

It is obvious that Nordenfelt's case goes far beyond Bell's; for in Nordenfelt's case, it was legally certain at the date of the English patent (May 13), that the Belgian patent, when granted, *must* be dated and take effect as of May 12, the date of the application already filed. And if the subject matter permitted an English patent, then it was one which gave a Belgian patent as matter of right and therefore with certainty on the application.

But in Bell's case, *all* these matters remained to be judicially determined.

Holste v. *Robertson*, L. R., 4 Ch. 9, turned upon the effect which an English court should give to the date of an English patent, when its validity only came in question, the contention being that a foreign patent obtained after the date of the English patent, but before its actual sealing, destroyed it. The whole opinion is as follows: —

JAMES, L. J. "I am of opinion that there is no ground for this application. The words of the Act of Parliament are clear; the grant of the patent takes effect from the day on which it is dated.

The 24th section says that when Letters Patent are issued as of any day prior to the day of actual sealing, they shall have the same force and validity as if they had been sealed on the day as of which they are expressed to be sealed. Therefore, they must be held to have been granted on that day, for all the purposes of the Act. The appeal must be dismissed with cost."

THE UNITED STATES PATENT LAW.

Section 4,887 of the Revised Statutes of the United States, with which the issues here under consideration are concerned, is as follows: —

"No person shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid by reason *of its having been first patented, or caused to be patented, in a foreign country, unless the same has been introduced into public use in the United States for more than two years prior to the application.* But every patent granted for an invention which has been previously patented in a foreign country, shall *be so limited as to expire at the same time with the foreign patent;* or if there be more than one, at the same time with the one having the shortest term, and in no case shall it be in force more than seventeen years."

Upon this, two questions arise in the case at bar: —

First. In this case, at the grant of the United States patent, no patent had been granted in England, the inquiry whether a patent ought to be granted in England had not been made nor even entered upon, and the only paper which ascertains with legal certainty what invention is "patented" (the "complete" specification), had not been written. The "provisional specification" had been filed, and the so-called "provisional protection" been reached, but nothing more.

Was any invention, and if so, what invention "patented" in England by these proceedings within the meaning of the United States statute?

Or, in other words, is an invention described (but not even claimed) in a provisional specification a "patented" invention during the time between the day the petition is filed in England and the day when the English authorities determine whether a patent shall be issued, and actually seal and grant it?

Second. If the inventions claimed in the United States patent of Jan. 30, 1877, were then patented in England, is the United States patent void *ab initio*, because upon its face it does not express the limitation of the statute?

Both of these inquiries have been repeatedly answered in favor of the complainants.

When is an invention "patented" in England within the Revised Statutes?

R. S. 4886 and 4887 both employ the phrase ("*patented in a foreign country*" in one, and "*patented in any foreign country*" in the other) which had for nearly forty years found its place in the corresponding sections of the older statutes. The employment of them in 1873, therefore, is a legislative adoption of the meaning the published decision of the courts had given them.

By St. 1836, § 7, the patent is not to be granted, and by § 15 (from which R. S. 4886 is copied) it is to be adjudged void, if, before the invention by the patentee, the alleged novelty had been "patented . . . in this or any foreign country."

Knowledge of it abroad was no obstacle; the statute called for that condition of things signified by the word "patented," and to that it gave a weight which it did not give to public knowledge and general use.

Patents at that time invariably were and in most countries still are in manuscript. The most widely circulated and most publicly exhibited written description is not enough. The effect is not given to a written description as full, complete and accessible as a patent can be supposed to be. The statute calls for a *patent* in the one case or a *printed* publication in the other, and is satisfied with nothing short of those physical things. There is nothing in the statute to give the same effect to a description accompanying an application for any English patent which is given to the patent itself. Making public a description (not in print), is of no effect; there must be a "*patent*" to be made public.

Several statutes concern themselves with the case when the invention of the applicant has been "patented" in the United States and abroad. The most important is St. 1839, § 6, which was the principal origin of R. S. 4887. All these statutes inquire in terms

when the invention was "patented in a foreign country," in order that the date thereof may be compared under St. 1839, with the date of the American application, and under later statutes with the date of the American patent.

One class of these statutes compares the foreign date with our American date, and entails one legal consequence; the other compares the foreign date with a different American date, and entails a different consequence.

But both, now embodied in consecutive sections of the same statute, equally require the Court to ascertain: —

1. The date when something became "patented in a foreign country."

2. Precisely what invention was "patented."

And in both cases, with a view to destroy or to shorten the life of a United States patent.

The same phrase cannot be so used with essentially diverse meanings.

Meaning of word "Patented." — As to the first point, the words, "patented in a foreign country," *ex vi termini*, are used to express the fact (and have no meaning unless they do express it), that a right to use the invention exists in some one to the exclusion of the public at large; and the time when the invention becomes patented cannot be before the first instant when such right exists. Nor can it be said that a particular invention is patented until the means exist for ascertaining what invention it is that the patentee has an exclusive right to enjoy.

Accordingly, the United States courts have uniformly decided that, in respect of an English patent the word means that the Letters Patent must have been actually sealed, and the specification which the English law looks at to know what is patented, must be filed, before the invention described in a particular United States patent can be known or decided to be "patented" in England.

O'Reilly v. *Morse*, 15 How. 62 (1853). The Supreme Court here passed upon both clauses. Under Stat. 1836, §§ 7, 15, they held that they could not find the invention of Morse to have been

"patented" in England by Wheatstone and Cooke, until the English patent had been sealed, and final specification filed. See also p. 38, *infra*.

Smith v. *Dental Vulcanite Co.*, 93 U. S. 486, 498. STRONG, J.: —

"Yet taking the spring of 1855 as the time when it [the invention by the patentee, Dr. Cummings] was completed, we find nothing in the proofs to justify a conclusion that Dr. Cummings was not the first inventor. . . . Of the English patent of Charles Goodyear, it is enough to say that although the provisional specification was filed March 14, 1855, the completed specification was not until the 11th of September following."

The terms of the statute (1836, § 15) under which that patent was granted, raised the inquiry whether "the invention or any part thereof," — "the same or any substantial part thereof, had before *been patented* or described in any printed publication." The English patent was of 1855, and therefore *granted under the same statute as Morgan-Brown's*, — Act. 15 and 16 Vict., 1852.

The Corn-planter Patent, 23 Wall. 211. The language of Stat. 1836, § 7, is: "or that it had been patented, . . . in this or any foreign country." Whereupon, the Court decided that when proceedings touching an invention had not got beyond an application, the invention was not "patented."

An application duly filed, not rejected, but voluntarily withdrawn, was set up. *Held* that the invention described in that application was not "patented." The Court said: —

"Had a patent been actually granted to Remy and Kelly, it would have been different. The case would then have come directly within the seventh section of the Act of 1836, which makes a 'patent' or a 'description in a printed publication' of the invention claimed a bar to a further patent therefor, but a mere application for a patent is not mentioned as such a bar."

There is even less reason to hold that an English application accompanied merely by a "provisional" specification, should be held equivalent to the "patenting" of an invention.

U. S. Decisions as to when an invention is "patented" in England within R. S. 4887.

The clause involved in this case (R. S. 4887, and its predecessors) have been construed, and the date when an invention is "patented" in England has been repeatedly settled.

Am. Diamond Rock-boring Co. v. *Sheldon*, 17 Blatch. 303. The patent was granted when Stat. 1839, § 6, was in force. If the invention was "patented" in England *more* than six months before the United States application, the statute applied, and the United States patent had expired. If it was not patented in England more than six months before the United States application, then the case did not come within the statute, and the United States patent ran seventeen years from its date and was still in force. The *date* of the English patent was *more* than six months, but the filing of the English complete specifications was *less* than six months before the United States proceedings. The Court stated the question: "The question is, was it *patented* there before the specification was filed?" and held that it was not. In that case, the English patent was granted under Act 1882. SHIPMAN J. also sustained this patent. (14 Bl. 119.)

Gold & Stock Co. v. *Commercial Telegram Co.*, 23 Fed. R. 340 (1885). The precise question at bar was here decided. Calahan was the American inventor and patentee. His English patent was dated March 16, 1868, the day when his provisional specification was filed, but it was actually sealed Aug. 21, 1868. The United States patent was April 21, 1868, a month after the *date* of the English patent, but five months before the *sealing* of that patent. The English patent was issued under Act 1852, 15 and 16 Vict.

The Court; SHIPMAN, J., thus announced its decision: "In this case, the English patent was sealed five months after the patent in suit was issued; and although the English patent was when published dated March 16, 1868, I do not suppose that such date has an effect upon the life of the subsequently issued United States patent." (P. 343.)

The second question, viz., whether if the statute applies, the limitation must be expressed on the face of the American patent, or the latter is void *ab initio*, has received the most authoritative decision.

One *vis major* applies to this case, to wit, the physical impossibility of writing on Jan. 30, 1877, the date or the day of expiration of an English patent which did not exist, and the date of which, if it

should thereafter exist, was not fixed by anything then done. But we are now concerned with United States decisions.

O'Reilly v. *Morse*, 15 How. 62 (1853). Morse's United States patent was granted in 1840, when Stat. 1839, § 6, was in force. He took out a French patent, Oct. 30, 1838. Concerning cases which came within the statute, the enactment was: —

"Provided, also, that in all cases every such patent shall be limited to the term of fourteen years from the date or publication of such foreign patent."

In Smith *v.* Ely, Judge McLean held that the Morse patent was void *ab initio* under this statute. His ground was that the Commissioner had no authority to issue any patent except one for the time so limited on its face and in terms, and that any other patent was *ultra vires* and void.

In Morse *v.* O'Reilly, Judge Munroe held that the statute applied, but that the law gave the limitation to the term, and that it need not be expressed on the face of the patent; and inasmuch as fourteen years from the date of the French patent had not elapsed when he heard the case, he sustained the patent and granted an injunction.

The two cases were argued together in the Supreme Court. At that time (Dec. T. 1853), the fourteen years had run, but they had not run when the case reached the Supreme Court docket.

The effect of this statute was one of the chief points of contention, the other being the eighth claim. GRIER, J., in his dissenting opinion, styled them the two great points of the case. The Court thus dealt with it: —

"Nor is it void because it does not bear the same date with his French patent [Oct. 30, 1838]. It is not necessary to inquire whether the application of Professor Morse to the Patent Office in 1838, before he went to France, does or does not exempt his patent from the operation of the Act of Congress upon the subject; for if it should be decided that it does not exempt it, the only effect of that decision would be to limit the monopoly to fourteen years from the date of the foreign patent; and in either case, the patent was in full force at the time the injunction was granted by the Circuit Court and when the present appeal stood ready for hearing in this Court."

[But if the statute applied, the patent had expired when the case was heard and decided, — Dec. Term, 1853.]

GRIER, J., dissenting upon what he declared was one of the two great points of the case, thought that if the statute applied, it made the patent void unless the limitation appeared on its face, but that the case did not come within the statute. Evidently, the question received full and careful judicial consideration.

O'Reilly v. *Morse* is absolutely decisive of the case at bar upon two grounds.

First. The Supreme Court there held that since it was not a fatal defect that the patent did not state the alleged limitation on its face, and therefore was not void *ab initio*, a decree for an injunction and account ought to be made, and would be sustained on appeal without deciding whether the statute would apply, or at what future day the patent would expire.

In Mr. Bell's case it was both a legal and a physical impossibility for the Commissioner, on Jan. 30, 1877, to write on the face of patent 186,787, whether what we *now* know as English patent 4,765 would exist, nor when it would be granted, nor when it would be dated, nor when it would expire, nor what inventions would be "patented" by it. If R. S. 4887 requires these things to be written into every U. S. patent to which that section applies, then the section cannot apply to a patent which leaves the Patent Office before those things can be known. If it does not require them to be written in, then it is not needful for this case to inquire whether this patent expires Dec. 9, 1890, or Jan. 30, 1894.

Second. The legislation which resulted in R. S. 4887 is as follows: —

Stat. 1836, § 8. "But nothing in this act contained shall be construed to deprive an original and true inventor of the right to a patent for his invention, by reason of his having previously taken out Letters Patent therefor in a foreign country, and the same having been published at any time *within* six months next preceding the filing of his specification and drawings."

Stat. 1839, § 6. "*No person shall be debarred from receiving a patent* for any invention or discovery . . . *by reason of the same having been patented in a foreign country* more than six months prior to his application; *provided*, that the same shall not have been introduced into public and common use in the United States prior to the application for such patent; *and provided*, also, that in all cases, every such patent shall be limited to the term of four-

teen years from the date or publication of such foreign Letters Patent."

Morse "obtained" his French patent Oct. 30, 1838. This date was not discussed, and was assumed. His United States patent was, so it was said, applied for April 7, 1838, and granted June 20, 1840. It was alleged that the date of his U. S. patent, and not the date of his U. S. application, was what was to be compared with the foreign patent, and that his case came within Stat. 1839, sect. 6. If it did apply, there was a strong argument based on the language of the statute that the patent was void unless it stated the limitation. For, assuming that under the old law the patent could not issue, it enacted that it might, "PROVIDED that in all such cases every such patent shall be limited to the term, *etc.*" It was not unreasonable, if an argument on words was to prevail, to say that the saving of the statute only applied to patents which came within the description in the proviso, and therefore that no power existed to issue any patent for any different terms. As Judge Grier put it in his dissenting opinion, "it gives no power to the officer to issue a patent for a greater term." And he adds: —

"If the patent does not show the true commencement of the term granted by it, the patentee has it in his power to deceive the public by claiming a term of fourteen years, while in reality it may not be more than one."

Judge McLean on the circuit took the same view (5 McLean, 76).

But those views, argued by counsel and doubtless argued by Judge Grier with his usual vigor in the consultation room, *were expressly overruled by the Court*. Those questions are forever at rest.

The subsequent legislation has adopted that decision.

The Act of 1861 had no direct reference to this subject, and had no counterpart to these sections.

The act of 1870 had a section (25) on the subject employing the word "provided," but otherwise somewhat different in verbiage from the earlier Acts.

R. S. 4887. "*No person shall be debarred from receiving a patent* for his invention or discovery, nor shall any patent be declared invalid *by reason of its having been first patented*, or caused to be patented, *in a foreign country*, unless the same has been introduced into public use in the United States for more than two years prior to the application. But every patent granted for an invention which

has been previously patented in a foreign country shall be so limited as to expire at the same time with the foreign patent; or, if there be more than one, at the same time with the one having the shortest term, and in no case shall it be in force more than seventeen years."

The draughtsman evidently had before him the language of Stat. 1839, § 6, and copied the first clause substantially and in all the important phrases literally. Thus the form of it is, "no person shall be debarred," etc., and the essential words are: —

In 1839, "by reason of the same having been patented in a foreign country."

R. S., "by reason of its having been first patented in a foreign country."

The second clause, about public use, follows the verbiage of 1839 in all important words; it has no bearing on this case.

The third clause also adopted the verbiage of 1839.

In 1839. "Every such patent *shall be limited* to the term of, etc."

R. S. "Every patent granted, etc., *shall be so limited* as to expire."

"*Shall be limited*" is the phrase in both, and it was under that phrase that the Supreme Court held that the law supplied the limitation, and that the patent need not express it.

When Congress re-enacted the words to which a meaning had already been given by the Supreme Court, the final arbiter of the meaning of a U. S. Statute, it enacted that construction as much as if it had said so in terms.

Congress did more than that. Stat. 1839 assumes that patents previously could not be granted in a certain class of cases, and then enacts an exception out of that class. If we confine ourselves to the language merely, we might well think that the authority of the Commissioner only exists in respect of patents which come within the words of the exception, — in the term granted as well as in other particulars. This argument, urged by Judge Grier, derives considerable additional force from the fact that the whole section consists of one sentence, and that the phrase "shall be limited" is introduced by the word "provided."

But in R. S. 4887, the permissive clause, "no person shall be debarred," etc., ends with a period, and the phrase "shall be limited is in a separate sentence, beginning with "But."

More than that. Stat. 1839 has two clauses, each equally introduced by the word "provided"; and it is plain that a failure to come within the public-use clause, affects the patent, though it requires nothing to be stated in the patent. In R. S. 4887, the draughtsman has put the public-use clause into the first sentence, and expressly made it a qualification, introducing it by the word "unless," while he has done all that he could to disconnect the "shall be limited" clause from the former.

Verbal criticisms of a statute are of doubtful value, but here it is found that the draughtsman copied the words to which a meaning had been given, and changed and omitted those which might seem at variance with it. That the legislature did this, and did not in terms repudiate or exclude the meaning judicially given to the clauses, is absolutely conclusive.

The precise question came up before Judge Wallace in

Canan v. *Pound M'f'g Co.* 23 Fed. R. 185 (1885).

The whole opinion is devoted to a careful consideration of it. We quote the opinion in full: —

WALLACE, J. "The defendant insists that the plaintiff's patent is void, because it is granted for the term of seventeen years from the date of its issue, Aug. 12, 1879, and is not limited upon its face to expire Dec. 5, 1883, the time of the expiration of the plaintiff's Canadian patent for the same invention. This position is founded on the language of Sect, 4,887, Rev. St., which declares that every patent granted for an invention which has been previously patented in a foreign country shall be so limited as to expire at the same time with the foreign patent, or, if there be more than one, with the one having the shortest term; and in no case shall it be in force more than seventeen years. Reading this section without reference to the context, it would fairly authorize the argument that the limitation should be expressed upon the face of the patent; and if this were the true meaning of the law, a serious question would arise whether a patent issued in disregard of the mandate would not be void. But the section is to be read in connection with sections 4,883, 4,884 and 4,885, and resort may be had for interpretation to the pre-existing statutes; and thus read there seems to be no room for fair doubt that section 4,887 is not to be construed as requiring the limitation to be expressed in the patent, but merely as controlling the effect or duration of the grant.

Sections 4,883, 4,884 and 4,885 prescribe the formalities by which patents shall be authenticated, and what they are to recite and con-

tain. Sect. 4,884 enacts that 'every patent shall contain a short title or description of the invention or discovery, . . . and a grant to the patentee, his heirs or assigns, for the term of seventeen years, of the exclusive right to make, use and vend the invention,' etc.

"There is an apparent conflict between the requirements of this section and those of Sect. 4,887, but upon resorting to the original sources of the provisions, it will be seen that the conflict is apparent only. Where the meaning of the Revised Statutes is plain, the Court cannot recur to the original statutes to see if errors were committed in revising them, but it may do so when necessary to construe doubtful language used in the revision. United States *v.* Bowen, 100 U. S. 508. Sects. 4,883, 4,884, 4,885, and 4,887 are reproduced from Sects. 21, 22, 23, and 25 of the Act of July 8, 1870, revising and amending the statutes relating to patents. The first three sections relate to the regulations which are to be observed by the executive department respecting the form and contents of the instrument which they are to issue to the patentee. Sect. 25 relates to the rights which may be acquired by an inventor or discoverer who has previously patented his invention in a foreign country. It did not enact that his patent should 'be limited so as to expire' at the same time with his foreign patents, but declared that his patent should 'expire at the same time' with the foreign patent. Obviously, Congress was considering the effect and extent of the grant to such a patentee, the estate with which he would be invested when his patent had been issued, and not the formal requisites or terms of the instrument evidencing the grant. This is very clear by reference to the other provisions of that section, all of which relate to conditions which may defeat his patent.

"The change of phraseology in Sect. 4,887, by which the words 'shall be so limited as to expire' are substituted in place of the words in Sect. 25, 'shall expire at the same time,' should not be interpreted as intended to control the provisions of Sect. 4,884. The word 'limited,' as used in reference to the term of duration of a patent, where the invention has been first patented in a foreign country, originated in Sect. 6 of the patent act of 1839, where it was declared that 'every such patent shall be limited to the term of fourteen years from the date or publication of such foreign Letters Patent.' In the case of Smith *v.* Ely, 5 McLean, 76, it was held that the patent to Morse for the electric telegraph, was void under this section, because having first been patented in France, the Letters Patent here did not upon its face limit the term of the grant to fourteen years from the date or publication of the foreign patent. The Court held that the patent was issued not only without authority of law, but in violation of it. This conclusion was overruled by the Supreme Court, in O'Reilly *v.* Morse, 15 How. 62, where the point was distinctly made that the patent was void, because it ran fourteen years from the date of its issue, instead

of that length of time from the date of the French patent; but the Court held that the only effect of the French patent was to limit the monopoly to fourteen years from the date of that patent. From that time to the present, the general practice of the Patent Office, it is understood, has been to issue patents where a foreign patent has been obtained by the patentee, reciting a grant for the full term authorized by law in the case of ordinary patents without any limitation upon the face of the instruments. *If it had been intended in the revision of the statutes to introduce a new rule or change the construction which had been placed by the Supreme Court and the executive department upon the former provisions of law, plain and unequivocal language would have been employed, which would have demonstrated that intention beyond a doubt.*

"In several cases in this circuit and other circuits, similar patents have been under consideration, and been treated as valid for the term of the foreign patent, although upon their face they specified a longer term. Weston *v.* White, 13 Blatchf. 364; Henry *v.* Providence Tool Co., 3 Ban. & A. 501, Reissner *v.* Sharp, 16 Blatchf. 383; DeFlorez *v.* Raynolds, 17 Blatchf. 436; S. C. 8 Fed. Rep. 434; Holmes Electric Co. *v.* Metropolitan Co., 21 Fed. Rep. 458. The point now taken was not considered in these cases, but it could not have escaped the attention of the judges. No Court would direct a decree or order a preliminary injunction upon a patent void upon its face, and the circumstance that the point was not adverted to, implies that it was not thought to have any merit.

"Judgment is ordered for plaintiff for $133, with interest."

It is certain that under the English law, the filing of a provisional specification is not only not a patent, but the English statute specifically points out that it has not the effect of a patent, its only object being to enable the applicant to experiment in public with his invention without losing the right to obtain a patent in consequence thereof; and in that regard, it is the equivalent of the two years' clause in the American statute.

It is also clear that the words "previously patented in a foreign country" have been constantly held in this country not to signify the filing of a provisional specification; but, on the contrary, it has been held under various aspects that the real date when the invention became *patented* was the date when the foreign patent actually took effect in favor of the inventor, and that was the date intended by the American statute.

Any other view than that would necessarily lead to the most absurd consequences. Take the case at bar. Bell's provisional speci-

fication was filed Dec. 9, 1876. Under the English statute, a question to be decided in the future was whether a patent ever would issue to him; and the decision of the question did not depend upon himself, but upon the decision of the law officers in England. Perhaps, in the mean time, an English newspaper might have published fuller accounts of his American exhibitions than he was aware of, or some other person might have taken a patent for the same invention, and then he could not have had one. Whether, when it was granted, it would be dated as of the date of the original application and provisional specification or as of the date when it was granted, could not be known, because by law it might be dated at any time between those two days; and what would be its date could not be known at all; and yet if the law required him to solve in advance those questions over which he himself did not have control, and fix a date on his patent, it then might happen that that would be a false date under any circumstances; and if, after all, his English patent should not be granted to him, which by law it might not be, then he would have limited his American patent upon the face of it, when in point of fact, no foreign patent ever existed at all.

These consequences are so unreasonable that we submit no court should declare an American patent void because the patentee had not, with prophetic vision, foreseen events which had not occurred when he took it, and had his prophecy recorded in his American patent.

But the decision of the very point in O'Reilly *v.* Morse, and in the Gold and Stock case, would seem to be sufficient.

Not much aid in construing the statute is to be derived from any assumption as to the policy or object of the law. It is sometimes suggested that the object of the restriction of Sect. 4,887 is to place the people in this country on the same footing, with reference to the invention, as the people of other countries, on the ground that it would be unjust or unwise to give a right of property in an invention here after the people of another country had acquired the right to it without restriction. But this can hardly be so, since the law does not make it the condition of the grant of a patent here that the inventor shall take out patents in other countries.